

Applicants: Tamir Ben-David et al.  
U.S. Serial No.: 10/719,659  
Filed: November 20, 2003  
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Remarks

Non-Compliant Item 4: Missing Signature for Amendment to the Claims:

In the November 2, 2009 Notice of Non-Compliant Amendment the Examiner asserted that the Amendment in Response to April 28, 2009 Office Action, Petition for a Three-Month Extension of Time and Supplemental Information Disclosure Statement, which applicants filed by mail on September 28, 2009 is missing a signature for the Amendments to the Claims.

In response, applicants submit that the September 28, 2009 Amendment was signed on page 28 as can be seen by reviewing the Amendment on the USPTO's PAIR website. Applicants attach as **Exhibit B** hereto a copy of the Amendment excluding the exhibits. As indicated above the Amendment is clearly signed on page 28. Accordingly, applicants respectfully request that the Examiner reconsider and withdraw the Notice and enter the Amendment mailed September 28, 2009, a true copy of which is attached hereto as **Exhibit B**.

Non-Compliant Item 5: Amendment Unsigned or Not Signed in Accordance with 37 C.F.R. §1.4:

In the November 2, 2009 Notice of Non-Compliant Amendment the Examiner asserted that the Amendment mailed September 28, 2009 was unsigned or not signed in accordance with 37 C.F.R. §1.4 and referred applicants to 37 C.F.R. §1.121 and M.P.E.P. §714 for further explanation of the amendment format. Copies of 37

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C.F.R. §§1.4 and 1.121 and M.P.E.P. §714 are attached hereto as **Exhibits C-E**, respectively.

In response, applicants have reviewed 37 C.F.R. §1.121 and M.P.E.P. §714 and maintain that the Amendment was signed in accordance with 37 C.F.R. §1.4, by a person with authority to prosecute the application.

37 C.F.R. §1.4(d)(1) requires that each piece of correspondence filed in an application which requires a person's signature, must "[b]e an original, that is, have an original handwritten signature personally signed, in permanent dark ink or its equivalent, by that person[.]" The Amendment mailed September 28, 2009 contains an original handwritten signature of the undersigned attorney on page 28. In addition, the amendment also contains the undersigned attorney's printed name and registration number below his signature. Accordingly, applicants maintain that the Amendment is in compliance with the applicable rules.

Applicants further submit that in accordance with 37 C.F.R. §1.33(b), a copy of which is attached hereto as **Exhibit F**, the September 28, 2009 Amendment as filed was signed by a registered patent attorney of record appointed in compliance with the Power of Attorney requirement of 37 C.F.R. §1.32(b), a copy of which is attached hereto as **Exhibit G**. See also M.P.E.P. §714.01.

Accordingly, applicants respectfully request that the Examiner reconsider and withdraw the November 2, 2009 Notice and enter the Amendment mailed September 28, 2009, a true copy of which

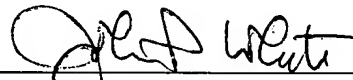
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is attached hereto as **Exhibit B**.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

No fee is deemed necessary in connection with the filing of this Communication. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,



John P. White  
Registration No. 28,678  
Attorney for Applicants  
Cooper & Dunham LLP  
30 Rockefeller Plaza  
New York, New York 10112  
Tel. No. (212) 278-0400

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to:

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450



John P. White Date  
Reg. No. 28,678

3/24/98624

JW/A:

<b>Notice of Non-Compliant Amendment</b> <b>(37 CFR 1.121)</b> RECEIVED COOPER & DINWIDDIE DOCKET CLERK <i>asm</i>	Application No. 10/719,659	Applicant(s) BEN-DAVID ET AL. Art Unit 3998
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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

The amendment document filed on 30 September, 2009 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121 or 1.4. In order for the amendment document to be compliant, correction of the following item(s) is required.

THE FOLLOWING MARKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☐ 1. Amendments to the specification:
- ☐ A. Amended paragraph(s) do not include markings.
  - ☐ B. New paragraph(s) should not be underlined.
  - ☐ C. Other \_\_\_\_\_.
- ☐ 2. Abstract:
- ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
  - ☐ B. Other \_\_\_\_\_.
- ☐ 3. Amendments to the drawings:
- ☐ A. The drawings are not properly identified in the top margin as "Replacement Sheet," "New Sheet," or "Annotated Sheet" as required by 37 CFR 1.121(d).
  - ☐ B. The practice of submitting proposed drawing correction has been eliminated. Replacement drawings showing amended figures, without markings, in compliance with 37 CFR 1.84 are required.
  - ☐ C. Other \_\_\_\_\_.
- ☒ 4. Amendments to the claims:
- ☐ A. A complete listing of all of the claims is not present.
  - ☐ B. The listing of claims does not include the text of all pending claims (including withdrawn claims)
  - ☐ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified. Note: the status of every claim must be indicated after its claim number by using one of the following status identifiers: (Original), (Currently amended), (Canceled), (Previously presented), (New), (Not entered), (Withdrawn) and (Withdrawn-currently amended).
  - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
  - ☒ E. Other: Signature is missing.
- ☒ 5. Other (e.g., the amendment is unsigned or not signed in accordance with 37 CFR 1.4): For further explanation of the amendment format required by 37 CFR 1.121, see MPEP § 714.

NON-COMPLIANT Amendment 12-209  
 2nd 1-2-10  
 3rd 2-2-10  
 4th 3-2-10  
 5th 4-2-10  
 6th 5-2-10

TIME PERIODS FOR FILING A REPLY TO THIS NOTICE:

- Applicant is given **no new time period** if the non-compliant amendment is an after-final amendment or an amendment filed after allowance, or a drawing submission (only). If applicant wishes to resubmit the non-compliant after-final amendment with corrections, the **entire corrected amendment** must be resubmitted.
- Applicant is given **one month**, or thirty (30) days, whichever is longer, from the mail date of this notice to supply the correction, if the non-compliant amendment is one of the following: a preliminary amendment, a non-final amendment (including a submission for a request for continued examination (RCE) under 37 CFR 1.114), a supplemental amendment filed within a suspension period under 37 CFR 1.103(a) or (c), and an amendment filed in response to a Quayle action. If any of above boxes 1 to 4 are checked, the correction required is only the corrected section of the non-compliant amendment in compliance with 37 CFR 1.121.

**Extensions of time** are available under 37 CFR 1.136(a) only if the non-compliant amendment is a non-final amendment or an amendment filed in response to a Quayle action.

**Failure to timely respond** to this notice will result in:

**Abandonment** of the application if the non-compliant amendment is a non-final amendment or an amendment filed in response to a Quayle action; or

**Non-entry** of the amendment if the non-compliant amendment is a preliminary amendment or supplemental amendment.

Legal Instruments Examiner (LIE), if applicable /LINDA W. BADIE/

Telephone No: (571)272-7019






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23432 e 11/02/2009  
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NEW YORK, NY 10112

Paper No.

Application No.: 10/719,659 	Date Mailed: 11/02/2009
First Named Inventor: Ben-David, Tamir,	Examiner: BOCKELMAN, MARK
Attorney Docket No.: 78624/JPW/BB	Art Unit: 3766
Confirmation No.: 2380	Filing Date: 11/20/2003

Please find attached an Office communication concerning this application or proceeding.

Commissioner for Patents

# **EXHIBIT B**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants : Ben-David et al.  
Serial No. : 10/719,659 Examiner : Mark W. Bockelman  
Filing Date : November 20, 2003 Art Unit : 3766  
For : REDUCTION OF HEART RATE VARIABILITY BY  
PARASYMPATHETIC STIMULATION

30 Rockefeller Plaza, 20<sup>th</sup> Floor  
New York, New York 10112  
September 28, 2009

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**AMENDMENT IN RESPONSE TO APRIL 28, 2009 OFFICE ACTION, PETITION FOR  
A 3-MONTH EXTENSION OF TIME AND SUPPLEMENTAL INFORMATION DISCLOSURE  
STATEMENT**

This Amendment is submitted in response to the April 28, 2009 Office Action issued by the United States Patent and Trademark Office in connection with the above-identified application. The April 28, 2009 Office Action was issued as a supplemental Office Action to the October 30, 2008 Office Action following a December 1, 2008 Interview between Examiner Bockelman and Benjamin Fishman and reset the time period to respond. The April 28, 2009 Office Action set a shortened statutory period of two (2) months to reply. Therefore, a response to the April 28, 2009 Office Action was due June 28, 2009. Applicants hereby petition for a three-month extension of time to respond. The fee for a three-month extension of time for a small entity is FIVE HUNDRED FIFTY FIVE DOLLARS (\$555.00) and a check including this amount is enclosed. With a three-month extension of time a response is now due September 28, 2009. Accordingly, this response is being timely filed.

Please amend the subject application as follows:

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**Amendments to the Claims** begin on page 3 of this paper.

**Remarks** begin on page 18 of this paper.

**Information Disclosure Statement** begins on page 26 of this paper.

**Amendments to the Claims**

This listing of claims will replace all prior versions, and listings, of claims in the application.

**Listing of Claims:**

1. (Currently Amended) Apparatus comprising:

an electrode device, configured to be coupled to a site of a subject selected from the group consisting of: a vagus nerve, and an epicardial fat pad; and

a cardiac monitor, configured to detect a cardiac signal;  
and

a control unit, configured to:

drive the electrode device to apply a current to the site in respective pulse bursts in each of a plurality of cardiac cycles of the subject, and

configure the current to reduce heart rate variability of the subject below a baseline heart rate variability of the subject which corresponds to the subject's heart rate variability when the current is not applied, by initiating the applying of each burst after a delay of 30 to 200 milliseconds following an R-wave of the cardiac signal.

2. (Previously Presented) The apparatus according to claim 1, wherein the control unit is configured to configure the current to substantially not reduce a heart rate of the subject.
3. (Previously Presented) The apparatus according to claim 121, wherein the control unit is configured to configure the current to reduce the heart rate variability by at least 5% below the baseline heart rate variability during a time period

in which a heart rate of the subject is not reduced responsive to the current by more than 10% below a baseline thereof.

4. (Canceled)
5. (Previously Presented) The apparatus according to claim 1, wherein the control unit is configured to drive the electrode device during exertion by the subject.
6. (Previously Presented) The apparatus according to claim 1, wherein the control unit is configured to withhold driving the electrode device when the subject is not experiencing exertion.
7. (Previously Presented) The apparatus according to claim 1, wherein the control unit is configured to configure the current to reduce a heart rate variability of the subject having a characteristic frequency between about 0.15 and about 0.4 Hz.
8. (Previously Presented) The apparatus according to claim 1, wherein the control unit is configured to configure the current to reduce a heart rate variability of the subject having a characteristic frequency between about 0.04 and about 0.15 Hz.
9. (Canceled)

10. (Previously Presented) The apparatus according to claim 1, wherein the control unit is configured to drive the electrode device to apply the current in intermittent ones of a plurality of cardiac cycles of the subject.
11. (Canceled)
12. (Previously Presented) The apparatus according to claim 1, wherein the control unit is configured to drive the electrode device responsive to a circadian rhythm of the subject.
13. (Previously Presented) The apparatus according to claim 12, wherein the control unit is configured to drive the electrode device when the subject is awake.
14. (Previously Presented) The apparatus according to claim 12, wherein the control unit is configured to withhold driving the electrode device when the subject is sleeping.
15. (Previously Presented) The apparatus according to claim 1, wherein the control unit is configured to configure the current to reduce the heart rate variability by at least 10%.
16. (Previously Presented) The apparatus according to claim 15, wherein the control unit is configured to configure the current to reduce the heart rate variability by at least 50%.
17. (Previously Presented) The apparatus according to claim 1, wherein the control unit is configured to configure the

current to reduce a standard deviation of a heart rate of the subject within a time window.

18. (Previously Presented) The apparatus according to claim 17, wherein the control unit is configured to configure the current to reduce a standard deviation of the heart rate of the subject within a time window longer than 10 seconds.
19. (Previously Presented) The apparatus according to claim 18, wherein the control unit is configured to configure the current to reduce by at least about 10% the standard deviation of the heart rate within the time window longer than 10 seconds.
20. (Previously Presented) The apparatus according to claim 19, wherein the control unit is configured to configure the current to reduce by at least about 50% the standard deviation of the heart rate within the time window longer than 10 seconds.
21. (Canceled)
22. (Currently Amended) The apparatus according to claim 1 [[21]], wherein the control unit is configured to configure each pulse of each of the bursts to have a pulse duration of between about 0.1 and about 4 milliseconds.
23. (Previously Presented) The apparatus according to claim 22, wherein the control unit is configured to configure each pulse



of each of the bursts to have a pulse duration of between about 0.5 and about 2 milliseconds.

24. (Currently Amended) The apparatus according to claim 1 [[21]], wherein the control unit is configured to configure each of the bursts to have a pulse repetition interval of between about 2 and about 10 milliseconds.

25. (Previously Presented) The apparatus according to claim 24, wherein the control unit is configured to configure each of the bursts to have a pulse repetition interval of between about 2 and about 6 milliseconds.

26-27. (Canceled)

28. (Currently Amended) The apparatus according to claim 1 [[27]], wherein the control unit is configured to initiate the applying of each burst after a delay of about 50 to about 150 milliseconds following the [[an]] R-wave of the cardiac signal.

29. (Currently Amended) The apparatus according to claim 1 [[21]], wherein the control unit is configured to configure at least one of the bursts to have between about 0 and about 20 pulses.

30. (Previously Presented) The apparatus according to claim 29, wherein the control unit is configured to configure the bursts to have between about 1 and about 8 pulses during steady state operation.

31-33. (Canceled)

34. (Previously Presented) The apparatus according to claim 1, wherein the control unit is configured to configure the current to reduce a heart rate of the subject.

35. (Currently Amended) The apparatus according to claim 34,  
wherein the cardiac monitor is comprising a sensor,  
configured to detect the heart rate of the subject, and to generate a heart rate signal responsive thereto,  
wherein the control unit is configured to configure the current to reduce the heart rate of the subject toward a target heart rate, responsively to the heart rate signal.

36. (Previously Presented) The apparatus according to claim 35, wherein the target heart rate includes a target normal heart rate within a range of normal heart rates of the subject, and wherein the control unit is configured to configure the current to reduce the heart rate of the subject toward the target normal heart rate.

37. (Canceled)

38. (Previously Presented) The apparatus according to claim 120, wherein the condition includes heart failure of the subject, and wherein the control unit is configured to configure the current to reduce the heart rate variability by at least about 10% so as to treat the heart failure.

39. (Previously Presented) The apparatus according to claim 120, wherein the condition includes an occurrence of arrhythmia of the subject, and wherein the control unit is configured to configure the current to reduce the heart rate variability by at least about 10% so as to treat the occurrence of arrhythmia.
40. (Previously Presented) The apparatus according to claim 39, wherein the condition includes atrial fibrillation of the subject, and wherein the control unit is configured to configure the current to reduce the heart rate variability so as to treat the atrial fibrillation.
41. (Currently Amended) A method comprising:  
identifying a subject as being appropriate for reduction of heart rate variability of the subject below a baseline heart rate variability of the subject which corresponds to the subject's heart rate variability when parasympathetic stimulation is not applied;  
applying a current to a site of [[a]] the subject selected from the group consisting of: a vagus nerve, and an epicardial fat pad; and  
configuring the current to reduce in response to the identifying, treating a condition of the subject by reducing the heart rate variability of the subject below [[a]] the baseline heart rate variability of the subject when the current is not applied, by configuring the current.
42. (Original) The method according to claim 41, wherein applying the current comprises configuring the current to substantially not reduce a heart rate of the subject.

43. (Previously Presented) The method according to claim 126, wherein configuring the current comprises configuring the current to reduce the heart rate variability by at least 5% below the baseline heart rate variability during a time period in which a heart rate of the subject is not reduced responsive to the current by more than 10% below a baseline thereof.
44. (Canceled)
45. (Previously Presented) The method according to claim 41, wherein applying the current comprises detecting exertion by the subject and applying the current during the exertion.
46. (Previously Presented) The method according to claim 41, wherein applying the current comprises:
  - detecting whether the subject is experiencing exertion;
  - and
  - withholding applying the current when the subject is not experiencing exertion.
47. (Previously Presented) The method according to claim 41, wherein applying the current comprises configuring the current to reduce a heart rate variability of the subject having a characteristic frequency between about 0.15 and about 0.4 Hz.
48. (Previously Presented) The method according to claim 41, wherein applying the current comprises configuring the current to reduce a heart rate variability of the subject having a characteristic frequency between about 0.04 and about 0.15 Hz.

49. (Canceled)

50. (Previously Presented) The method according to claim 41, wherein applying the current comprises applying the current in intermittent ones of a plurality of cardiac cycles of the subject.

51. (Canceled)

52. (Previously Presented) The method according to claim 41, wherein applying the current comprises applying the current responsive to a circadian rhythm of the subject.

53. (Original) The method according to claim 52, wherein applying the current comprises applying the current when the subject is awake.

54. (Original) The method according to claim 52, wherein applying the current comprises withholding applying the current when the subject is sleeping.

55. (Previously Presented) The method according to claim 41, wherein applying the current comprises configuring the current to reduce the heart rate variability by at least 10%.

56. (Previously Presented) The method according to claim 55, wherein applying the current comprises configuring the current to reduce the heart rate variability by at least 50%.

57. (Previously Presented) The method according to claim 41, wherein applying the current comprises configuring the current to reduce a standard deviation of a heart rate of the subject within a time window.
58. (Previously Presented) The method according to claim 57, wherein applying the current comprises configuring the current to reduce a standard deviation of the heart rate of the subject within a time window longer than 10 seconds.
59. (Previously Presented) The method according to claim 58, wherein applying the current comprises configuring the current to reduce by at least about 10% the standard deviation of the heart rate within the time window longer than 10 seconds.
60. (Previously Presented) The method according to claim 59, wherein applying the current comprises configuring the current to reduce by at least about 50% the standard deviation of the heart rate within the time window longer than 10 seconds.
61. (Canceled)
62. (Currently Amended) The method according to claim 41 ~~[[61]]~~, wherein applying the current comprises configuring each pulse of each of the bursts to have a pulse duration of between about 0.1 and about 4 milliseconds.
63. (Original) The method according to claim 62, wherein applying the current comprises configuring each pulse of each of the

bursts to have a pulse duration of between about 0.5 and about 2 milliseconds.

64. (Currently Amended) The method according to claim 41 ~~[[61]]~~, wherein applying the current comprises configuring each of the bursts to have a pulse repetition interval of between about 2 and about 10 milliseconds.
65. (Original) The method according to claim 64, wherein applying the current comprises configuring each of the bursts to have a pulse repetition interval of between about 2 and about 6 milliseconds.
- 66-67. (Canceled)
68. (Currently Amended) The method according to claim 41 ~~[[66]]~~, wherein applying the current comprises initiating the applying of each burst after a delay of about 50 to about 150 milliseconds following the ~~[[an]]~~ R-wave of the cardiac signal.
69. (Currently Amended) The method according to claim 41 ~~[[61]]~~, wherein applying the current comprises configuring at least one of the bursts to have between about 0 and about 20 pulses.
70. (Original) The method according to claim 69, wherein applying the current comprises configuring the bursts to have between about 1 and about 8 pulses during steady state operation.

71-73. (Canceled)

74. (Original) The method according to claim 41, wherein applying the current comprises configuring the current to reduce a heart rate of the subject.

75. (Currently Amended) The method according to claim 74, wherein applying the current comprises detecting the heart rate of the subject, and configuring the current to reduce the heart rate of the subject toward a target heart rate, responsively to the heart-rate ~~signal~~.

76-77. (Canceled)

78. (Previously Presented) The method according to claim 127, wherein the condition includes heart failure of the subject, and wherein treating the condition comprises configuring the current to reduce the heart rate variability by at least about 10% so as to treat the heart failure.

79. (Previously Presented) The method according to claim 127, wherein the condition includes an occurrence of arrhythmia of the subject, and wherein treating the condition comprises configuring the current to reduce the heart rate variability by at least about 10% so as to treat the occurrence of arrhythmia.

80. (Previously Presented) The method according to claim 79, wherein the condition includes atrial fibrillation of the subject, and wherein treating the condition comprises



configuring the current to reduce the heart rate variability so as to treat the atrial fibrillation.

81-118. (Canceled)

119. (Previously Presented) The apparatus according to claim 1, wherein the control unit is configured to drive the electrode device to apply the current with an amplitude of between about 2 and about 10 milliamps.
120. (Previously Presented) The apparatus according to claim 1, wherein the control unit is configured to configure the current to treat a condition of the subject by reducing the heart rate variability.
121. (Previously Presented) The apparatus according to claim 1, wherein the control unit is configured to configure the current to reduce the heart rate variability by at least 5% below the baseline heart rate variability.
122. (Previously Presented) The apparatus according to claim 1, wherein the control unit is configured to configure the current to cause a prolonged reduced level of the heart rate variability.
123. (Previously Presented) The apparatus according to claim 35, wherein the control unit comprises an integral feedback controller that has inputs comprising the detected heart rate and the target heart rate, and wherein the control unit is

configured to configure the current responsively to an output of the integral feedback controller.

124. (Previously Presented) The apparatus according to claim 35, wherein the target heart rate is lower than a normal average heart rate of the subject, and wherein the control unit is configured to configure the current to reduce the heart rate of the subject toward the target heart rate.
125. (Previously Presented) The method according to claim 41, wherein applying the current comprises applying the current with an amplitude of between about 2 and about 10 milliamps.
126. (Previously Presented) The method according to claim 1, wherein applying the current comprises configuring the current to reduce the heart rate variability by at least 5% below the baseline heart rate variability.
127. (Canceled)
128. (Previously Presented) The method according to claim 41, wherein configuring the current comprises configuring the current to cause a prolonged reduced level of the heart rate variability.
129. (Previously Presented) The method according to claim 75, wherein configuring the current comprises configuring the current to reduce the heart rate toward the target heart rate responsively to an output of an integral feedback controller.

whose inputs comprise the detected heart rate and the target heart rate.

130. (Previously Presented) The method according to claim 75, wherein the target heart rate is lower than a normal average heart rate of the subject, and wherein applying the current comprises configuring the current to reduce the heart rate of the subject toward the target heart rate.

131. (Previously Presented) The method according to claim 75, wherein the target heart rate includes a target normal heart rate within a range of normal heart rates of the subject, and wherein applying the current comprises configuring the current to reduce the heart rate of the subject toward the target normal heart rate.

132. (New) A method comprising:

detecting a cardiac signal of the subject;

applying a current to a site of a subject in respective pulse bursts in each of a plurality of cardiac cycles of the subject, the site selected from the group consisting of: a vagus nerve, and an epicardial fat pad; and

configuring the current to reduce heart rate variability of the subject below a baseline heart rate variability of the subject which corresponds to the subject's heart rate variability when the current is not applied, by initiating the applying of each burst after a delay of 30 to 200 milliseconds following an R-wave of the cardiac signal.

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**Remarks**

This application contains claims 1-132, the status of which is as follows:

(a) Claims 42, 53-54, 63, 65, 70, and 74 are as originally filed.

(b) Claims 2-3, 5-8, 10, 12-20, 23, 25, 30, 34, 36, 38-40, 43, 45-48, 50, 52, 55-60, 78-80, 119-126, and 128-131 were previously presented.

(c) Claims 1, 22, 24, 28-29, 35, 41, 62, 64, 68-69, and 75 have been currently amended.

(d) Claims 4, 9, 37, 44, 49, 76-77, and 81-118 were previously canceled without prejudice, and claims 11, 21, 26-27, 31-33, 51, 61, 66-67, 71-73, and 127 have been currently canceled without prejudice.

(e) Claim 132 is new.

No new matter has been added.

Applicants thank Examiner Bockelman for the courtesy of a personal interview with Applicants' representative, Daniel Goldstein (Reg. No. 44,127), held in the USPTO on August 18, 2009. At the interview, the Applicants' representative and the Examiner discussed possible amendments to independent claims 1 and 41, as previously presented, in light of US Patents 6,341,236 to Osorio et al. and 6,571,121 to Schroepel et al. The Examiner agreed that the amendments to the claims made hereby appear to overcome the art as applied in the outstanding Office Action, subject to an additional reading of Osorio and Schroepel.

***Rejections under 35 U.S.C. 112***

Claims 1-3, 5-8, 10-36, 38-43, 45-48, 50-75, 78-80, and 119-131 were rejected under 35 U.S.C. 112, second paragraph, as being

indefinite. The Examiner argued that independent claims 1 and 41 "are ambiguous as to whether current is configured to lower heart rate variability below a baseline heart rate variability of the subject which **corresponds** to the heart rate variability when the current is not applied or whether the current drives the heart rate variability below a baseline when the current is turned off" (p. 2, emphasis in the original). Applicants have amended claims 1 and 41 to include clarifying language suggested by this rejection.

In addition, the Examiner argued that the apparatus recited in claim 1 does not necessarily lower heart rate variability, and may in certain circumstances simply provide stimulating current. Applicants have amended claim 1 to recite the configuration parameter previously recited in claim 27 (and intervening claims 21 and 26), namely that "the control unit is configured to initiate the applying of each burst after a delay of about 30 to about 200 milliseconds following an R-wave of the cardiac signal."

Furthermore, the Examiner argued that in method claim 41, "it is unclear if the 'results' are an intended result or an actual result since applicant does not claim that the subject heart rate variability is altered, only that the current is configured to alter the heart rate variability." Applicants have amended claim 41 to clarify that the results are actual results, and to emphasize that the method includes identifying a subject as being appropriate for heart rate variability reduction and treating the subject by reducing the heart rate variability.

Applicants thus respectfully submit that all of the pending claims are allowable under 35 U.S.C. 112, second paragraph.

***Rejections under 35 U.S.C. 102(b) and/or 103(a)***

***Osorio et al.***

Claims 1-3, 5-8, 10-36, 38-43, 46-48, 50-51, 53-55, 57-66, 69-75, 78, 120-124, and 126-131 were rejected under 35 U.S.C. 102(b) as

anticipated by, or, in the alternative, under 35 U.S.C. 103(a) as obvious over US Patent 6,341,236 to Osorio et al. Claims 119 and 125 were rejected under 35 U.S.C. 103(a) as being unpatentable over Osorio in view of US Patent 5,578,061 to Stroetman et al. Claims 45, 52, 56, 67-68, and 79-80 were rejected under 35 U.S.C. 103(a) as being unpatentable over Osorio in view of US Patent 6,571,121 to Schroepfel et al.

The Examiner wrote that he "believes that the Osorio et al. device is capable of reducing heart rate variability in a patient that has a pre-existing high heart rate variable condition baseline condition if it were applied to such a person." The Examiner also argued that Fig. 7 of Osorio "seems to show vagal stimulation that has reduced heart rate variability during VNS as opposed to prior and after the stimulation."

While disagreeing with these rejections, in order to expedite the issuance of a patent, Applicants have amended independent claim 1 and 41 as discussed hereinbelow.

*Independent method claim 41*

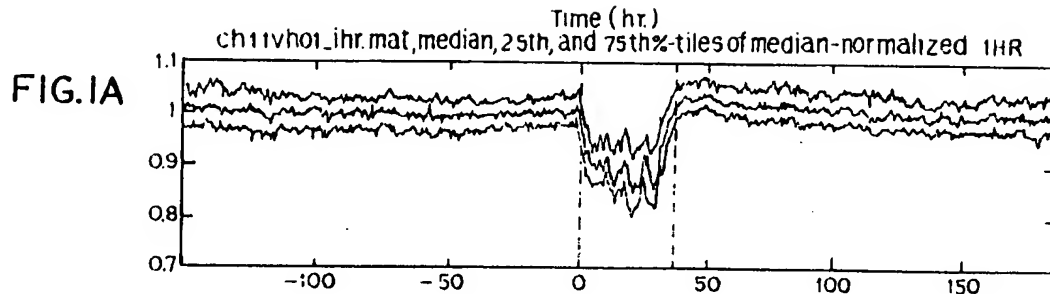
As discussed during the interview, Applicants have amended independent method claim 41 to further recite "identifying a subject as being appropriate for reduction of heart rate variability. . . ." and "in response to the identifying, treating a condition of the subject by reducing the heart rate variability. . . ." Support for these amendments is provided in the application as filed *inter alia* beginning at p. 70, line 22.

Applicants respectfully submit that although Osorio's device might be capable of being configured to practice the novel techniques recited in claim 41 as amended, there is no teaching or suggestion in Osorio to do so. Osorio teaches monitoring and modulating heart rate variability only to minimize undesired changes in heart rate variability caused by vagal stimulation for treating epilepsy. Osorio states, "It is an object of the present invention

to minimize or eliminate the effects on the heart caused by the electrical stimulation of the vagus nerve 60" (col. 8, lines 32-34; emphasis added). Thus, Osorio neither teaches nor suggests identifying a subject as being appropriate for reduction of heart rate variability below its baseline rate and treating a condition by reducing the heart rate variability. Indeed, doing so would run counter to Osorio's stated object of minimizing the effect of his stimulation on the heart.

Applicants now turn to Fig. 7, which was discussed during the interview. Although for the reasons described herein claim 41 is considered patentable over Osorio, and therefore the following discussion is not considered necessary to demonstrate the patentability of claim 41, Applicants nevertheless respectfully submit that Fig. 7 does not include sufficient data to draw any conclusion regarding the effect of Osorio's vagal stimulation on heart rate variability. The stimulation period is too short, and the non-stimulation period is much too short, to provide meaningful data for the type of analysis proposed by the Examiner. Even the data that are shown do not support the Examiner's assertion that heart rate variability decreased during the stimulation period. The Examiner's calculation fails to take into consideration, *inter alia*, the last four points during the stimulation period (between g5 and 37.7 seconds; see col. 10, lines 45-47), two of which have values of about 80 BMP. Inclusion of these points would substantially increase the heart rate variability according to the Examiner's calculation technique.

Furthermore, conventional vagal stimulation increases heart rate variability. Osorio himself clearly illustrates this vagal-stimulation-induced increase in heart rate variability in Fig. 1A (vagal stimulation was applied beginning at time 0):



Osorio himself understood that his vagal stimulation generally increases heart rate variability: "Generally, stimulation of the vagus nerve 60 increases heart rate variability (standard deviation) at higher IHR values. It is therefore desirable to provide a technique for vagus nerve stimulation that minimizes or has no effect on the normal operation of the heart as measured by the standard deviation of the IHR as a function of the IHR" (col. 8, line 65 - col. 9, line 4).

Applicants thus submit that independent claim 41, as amended, is patentable over Osorio. As discussed above, during the interview with Applicants' representative, the Examiner agreed that the amendments to claim 41 appear to distinguish over Osorio, subject to an additional reading of Osorio.

#### *Apparatus claims 1 and 27*

While not necessarily agreeing with the rejection of independent claim 1, Applicants have amended claim 1 to recite the configuration parameter previously recited in claim 27 (and intervening claims 21 and 26), namely that "the control unit is configured to initiate the applying of each burst after a delay of about 30 to about 200 milliseconds following an R-wave of the cardiac signal."

In rejecting dependent apparatus claim 27, the Examiner argued, "The device [of Osorio] can be started at any time and would be capable of being synchronized or unsynchronized and could be started anywhere in the cardiac cycle" (p. 7 of the office action).



Applicants respectfully submit that although Osorio's device might be capable of being configured to implement the novel delay parameter recited in claim 27, there is no teaching or suggestion in Osorio to do so. Applicants submit that this recited delay from the detected R-wave is not simply an engineering optimization, but instead may account for the surprising, unconventional heart-rate-variability-lowering effect of vagal stimulation recited in claim 1. Applicants note that a delay from the R-wave falling within the recited range is the first parameter given in the description of the dog experiment described on pp. 108-109 of the specification with reference to Fig. 6.

Applicants thus submit that independent claim 1, as amended, is patentable over Osorio. As discussed above, during the interview with Applicants' representative, the Examiner agreed that the amendments to claim 1 appear to distinguish over Osorio, subject to an additional reading of Osorio.

***Schroeppel et al.***

Claims 1-3, 5-8, 10-36, 38-43, 45-48, 50-75, 78-80, 86, and 119-131 were rejected under 35 U.S.C. 103(a) as obvious over US Patent 6,571,121 to Schroepel et al. in view of US Patent 6,341,236 to Osorio et al.

***Independent method claim 41***

The Examiner wrote, "The Examiner includes Osorio et al for its explicit teaching of currents reducing heart rate variability. To have made the reduction of heart rate variability the goal of the Schroepel treatments and used the Osorio et al techniques would have been obvious" (pp. 8-9 of the office action).

Schroeppel only briefly mentions using vagal stimulation for treating a patient having abnormal heart rate variability: "The next higher level 156 calls for a form of neural stimulation to stimulate vagal activity of the patient" (col. 9, lines 39-41). There is no

teaching or suggestion in Schroepfel that such vagal stimulation would be used to decrease heart rate variability. In fact, Schroepfel elsewhere expresses the conventional understanding that vagal activity is associated with increased heart rate variability: "As another factor, a smaller amount of variability exists at higher heart rates. For example, a person with a heart rate of 100 bpm typically will have more sympathetic nerve activity inhibiting vagal action. In this situation, the heart rate variability of the patient expectedly is extremely low" (col. 13, lines 37-42). In other words, Schroepfel believes that inhibition of vagal tone decreases heart rate variability.

Furthermore, as discussed above, Osorio does not teach treating a condition by applying vagal stimulation to reduce heart rate variability below a baseline level of the subject in the absence of such stimulation, as recited in claim 41. Even if Schroepfel were to suggest treating a heart condition by applying vagal stimulation to reduce heart rate variability, which he does not, Osorio provides no guidance that would enable one of ordinary skill in the art to configure vagal stimulation to deliberately reduce heart rate variability.

Applicants thus submit that claim 41, as amended, is patentable over Schroepfel in view of Osorio. As discussed above, during the interview with Applicants' Representative, the Examiner agreed that claim 41 as currently amended appears to distinguish over Schroepfel, subject to an additional reading of Schroepfel.

*Apparatus claims 1 and 27*

The Examiner gave no specific reasons for the rejection of claim 27 over Schroepfel et al. in view of Osorio et al. Applicants thus submit that claim 1, as amended to include the features previously recited in claim 27, is allowable at least for the reasons given above regarding the patentability of claim 1 over Osorio.

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In light of the suggested patentability of independent claims 1 and 41, all of the other pending claims are also in condition for allowance, being of narrower scope than the independent claims from which they directly or indirectly depend.

**New claim**

Independent claim 132 is new, and recites a method including features similar to those recited in apparatus claim 1, as amended hereby. Applicants respectfully submit that claim 132 is allowable for the same reasons discussed above regarding claim 1, as amended hereby.

The Applicant believes the amendments and remarks presented hereinabove to be fully responsive to all of the grounds of rejection raised by the Examiner. In view of these amendments and remarks, the Applicant respectfully submits that all of the claims in the present application are now in order for allowance. Notice to this effect is respectfully requested.

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SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

In accordance with their duty of disclosure under 37 C.F.R. §1.56, applicants direct the Examiner's attention to the following documents listed below which are also listed on the Form PTO-1449 (Substitute) attached hereto as **(Exhibit A)**.

Items 1-5 are U.S. Patents or U.S. Patent Publications. In accordance with 37 C.F.R. §1.98(a)(2)(ii) copies of these items are not provided. Copies of items 6-15 are attached hereto as EXHIBITS 1-10.

1. U.S. Patent No. 5,562,592, issued October 8, 1996, Neisz et al.;
2. U.S. Patent No. 6,477,406, issued November 5, 2002, Turcott et al.;
3. U.S. Publication No. 2003/0045914, published March 6, 2003, Cohen et al.;
4. U.S. Patent No. 6,885,888, issued April 26, 2005, Rezai et al.;
5. U.S. Patent No. 7,136,700, issued November 14, 2006, Province et al.;
6. International Publication No. WO 03/018113, published March 6, 2003, Biocontrol Medical Ltd. **(EXHIBIT 1)**;
7. International Publication No. WO 03/099377, published December 4, 2003, Biocontrol Medical Ltd.;-**(EXHIBIT 2)**;
8. Office Action, issued June 15, 2009, in connection with U.S.

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- Serial No. 11/064,446, filed February 22, 2005 (**EXHIBIT 3**);
9. Office Action, issued June 23, 2009, in connection with U.S. Serial No. 11/724,899, filed March 16, 2007—(**EXHIBIT 4**);
  10. Office Action, issued June 24, 2009, in connection with U.S. Serial No. 11/978,379, filed October 29, 2007 (**EXHIBIT 5**);
  11. Office Action, issued August 6, 2009, in connection with U.S. Serial No. 10/205,475, filed July 24, 2002 (**EXHIBIT 6**);
  12. Office Action, issued August 21, 2009, in connection with U.S. Serial No. 11/975,240, filed October 17, 2007 (**EXHIBIT 7**);
  13. Office Action, issued August 21, 2009, in connection with U.S. Serial No. 11/975,169, filed October 17, 2007 (**EXHIBIT 8**);
  14. Office Action, issued August 25, 2009, in connection with U.S. Serial No. 11/975,241, filed October 17, 2007 (**EXHIBIT 9**);
  15. Morillo et al., "Chronic Rapid Atrial Pacing: Structural, Functional, and Electrophysiological Characteristics of a New Model of Sustained Atrial Fibrillation," *Circulation*, 1995, 91(5), 1588-1595 (**EXHIBIT 10**);

The Examiner is respectfully requested to make these items of record in the present application by initialing and returning a copy of the enclosed Form PTO-1449 (Substitute).

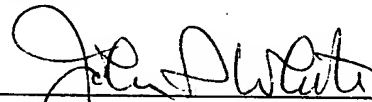
This Supplemental Information Disclosure Statement is being submitted under 37 C.F.R. §1.97(c) before the mailing of a Final Office Action. Pursuant to 37 C.F.R. §1.17(p), the fee for filing this Supplemental Information Disclosure Statement is \$180.00 and a check including this amount is enclosed.

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If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

No fee, other than the enclosed \$735.00, including \$555.00 for a Petition for a 3-Month Extension of Time and \$180.00 for filing a Supplemental Information Disclosure Statement, is deemed necessary in connection with the filing of this Amendment and Supplemental Information Disclosure Statement. However, if any fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

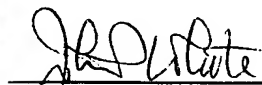
Respectfully submitted,



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Tel. No. (212) 278-0400

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to:

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

 9/28/09  
John P. White Date  
Reg. No. 28,678

# **EXHIBIT C**

(e) *Patent term extension.* All applications for extension of patent term under 35 U.S.C. 156 and any communications relating thereto intended for the United States Patent and Trademark Office should be additionally marked "Mail Stop Patent Ext." When appropriate, the communication should also be marked to the attention of a particular individual, as where a decision has been rendered.

(f) [Reserved]

[46 FR 29181, May 29, 1981; para. (d) added, 49 FR 34724, Aug. 31, 1984, effective Nov. 1, 1984; para. (e), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; para. (f) added, 52 FR 9394, Mar. 24, 1987; para. (g) added, 53 FR 16413, May 9, 1988; para. (h) added, 54 FR 37588, Sept. 11, 1989, effective Nov. 16, 1989; para. (i) added, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; para. (a) revised and para. (g) removed and reserved, 61 FR 56439, Nov. 1, 1996, effective Dec. 2, 1996; para. (b) revised, 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; paras. (a) and (d) revised, 66 FR 39447, July 31, 2001, effective Oct. 1, 2001; revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (a)(2) corrected, 68 FR 19371, Apr. 21, 2003, effective May 1, 2003; section heading, para. (a) introductory text and para. (a)(4) revised, para. (a)(2) removed and reserved, and note following para. (f) removed, 68 FR 48286, Aug. 13, 2003, effective Sept. 12, 2003; para. (c) revised, 68 FR 70996, Dec. 22, 2003, effective Jan. 21, 2004; para. (a)(4)(i) revised and para. (f) removed and reserved, 69 FR 29865, May 26, 2004, effective June 25, 2004; para. (a) introductory text revised and para. (a)(5) added, 69 FR 35427, June 24, 2004, effective July 26, 2004; para. (a)(1)(ii) revised and para. (a)(1)(iii) removed, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; para. (c)(1) revised, 72 FR 18892, Apr. 16, 2007, effective May 16, 2007; para. (d) revised, 73 FR 47534, Aug. 14, 2008, effective Oct. 2, 2008]

## § 1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

## § 1.3 Business to be conducted with decorum and courtesy.

Applicants and their attorneys or agents are required to conduct their business with the United States Patent and Trademark Office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Director and will not be entered. A notice of the non-entry of the paper will be provided. Complaints against examiners and other employees must be made in correspondence separate from other papers.

[Amended, 61 FR 56439, Nov. 1, 1996, effective Dec. 2, 1996; revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; revised, 68 FR 38611, June 30, 2003, effective July 30, 2003]

## § 1.4 Nature of correspondence and signature requirements.

(a) Correspondence with the Patent and Trademark Office comprises:

(1) Correspondence relating to services and facilities of the Office, such as general inquiries, requests for publications supplied by the Office, orders for printed copies of patents, orders for copies of records, transmission of assignments for recording, and the like, and

(2) Correspondence in and relating to a particular application or other proceeding in the Office. See particularly the rules relating to the filing, processing, or other proceedings of national applications in subpart B, §§ 1.31 to 1.378; of international applications in subpart C, §§ 1.401 to 1.499; of *ex parte* reexaminations of patents in subpart D, §§ 1.501 to 1.570; of extension of patent term in subpart F, §§ 1.710 to 1.785; of inter partes reexaminations of patents in subpart H, §§ 1.902 to 1.997; and of the Board of Patent Appeals and Interferences in part 41 of this title.

(b) Since each file must be complete in itself, a separate copy of every paper to be filed in a patent, patent file, or other proceeding must be furnished for each file to which the paper pertains, even though the contents of the papers filed in two or more files may be identical. The filing of duplicate copies of correspondence in the file of an application, patent, or other proceeding should be avoided, except in situations in which the Office requires the filing of duplicate copies. The Office may dispose of duplicate



copies of correspondence in the file of an application, patent, or other proceeding.

(c) Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

(d)(1) *Handwritten signature.* Each piece of correspondence, except as provided in paragraphs (d)(2), (d)(3), (e) and (f) of this section, filed in an application, patent file, or other proceeding in the Office which requires a person's signature, must:

(i) Be an original, that is, have an original handwritten signature personally signed, in permanent dark ink or its equivalent, by that person; or

(ii) Be a direct or indirect copy, such as a photocopy or facsimile transmission (§ 1.6(d)), of an original. In the event that a copy of the original is filed, the original should be retained as evidence of authenticity. If a question of authenticity arises, the Office may require submission of the original.

(2) *S-signature.* An S-signature is a signature inserted between forward slash marks, but not a handwritten signature as defined by § 1.4(d)(1). An S-signature includes any signature made by electronic or mechanical means, and any other mode of making or applying a signature not covered by a handwritten signature of § 1.4(d)(1). Correspondence being filed in the Office in paper, by facsimile transmission as provided in § 1.6(d), or via the Office electronic filing system as an attachment as provided in § 1.6(a)(4), for a patent application, patent, or a reexamination proceeding may be S-signature signed instead of being personally signed (*i.e.*, with a handwritten signature) as provided for in paragraph (d)(1) of this section. The requirements for an S-signature under this paragraph (d)(2) of this section are as follows.

(i) The S-signature must consist only of letters, or Arabic numerals, or both, with appropriate spaces and commas, periods, apostrophes, or hyphens for punctuation, and the person signing the correspondence must insert his or her own S-signature with a first single forward slash mark before, and a second single forward slash mark after, the S-signature (*e.g.*, /Dr. James T. Jones, Jr./); and

(ii) A patent practitioner (§ 1.32(a)(1)), signing pursuant to §§ 1.33(b)(1) or 1.33(b)(2), must

supply his/her registration number either as part of the S-signature, or immediately below or adjacent to the S-signature. The number (#) character may be used only as part of the S-signature when appearing before a practitioner's registration number; otherwise the number character may not be used in an S-signature.

(iii) The signer's name must be:

(A) Presented in printed or typed form preferably immediately below or adjacent the S-signature, and

(B) Reasonably specific enough so that the identity of the signer can be readily recognized.

(3) *Forms.* The Office provides forms to the public to use in certain situations to assist in the filing of correspondence for a certain purpose and to meet certain requirements for patent applications and proceedings. Use of the forms for purposes for which they were not designed is prohibited. No changes to certification statements on the Office forms (*e.g.*, oath or declaration forms, terminal disclaimer forms, petition forms, and nonpublication request forms) may be made. The existing text of a form, other than a certification statement, may be modified, deleted, or added to, if all text identifying the form as an Office form is removed. The presentation to the Office (whether by signing, filing, submitting, or later advocating) of any Office form with text identifying the form as an Office form by a party, whether a practitioner or non-practitioner, constitutes a certification under § 11.18(b) of this chapter that the existing text and any certification statements on the form have not been altered other than permitted by EFS-Web customization.

(4) *Certifications.* (i) *Section 11.18 certifications:* The presentation to the Office (whether by signing, filing, submitting, or later advocating) of any paper by a party, whether a practitioner or non-practitioner, constitutes a certification under § 11.18(b) of this subchapter. Violations of § 11.18(b)(2) of this subchapter by a party, whether a practitioner or non-practitioner, may result in the imposition of sanctions under § 11.18(c) of this subchapter. Any practitioner violating § 11.18(b) of this subchapter may also be subject to disciplinary action. *See* §§ 11.18(d) and 11.804(b)(9) of this subchapter.

(ii) *Certifications as to the signature:*

(A) *Of another:* A person submitting a document signed by another under paragraph (d)(2) of

this section is obligated to have a reasonable basis to believe that the person whose signature is present on the document was actually inserted by that person, and should retain evidence of authenticity of the signature.

(B) *Self certification*: The person inserting a signature under paragraph (d)(2) of this section in a document submitted to the Office certifies that the inserted signature appearing in the document is his or her own signature.

(C) *Sanctions*: Violations of the certifications as to the signature of another or a person's own signature, set forth in paragraphs (d)(4)(ii)(A) and (B) of this section, may result in the imposition of sanctions under § 11.18(c) and (d) of this chapter.

(e) Correspondence requiring a person's signature and relating to registration practice before the Patent and Trademark Office in patent cases, enrollment and disciplinary investigations, or disciplinary proceedings must be submitted with an original hand written signature personally signed in permanent dark ink or its equivalent by that person.

(f) When a document that is required by statute to be certified must be filed, a copy, including a photocopy or facsimile transmission, of the certification is not acceptable.

(g) An applicant who has not made of record a registered attorney or agent may be required to state whether assistance was received in the preparation or prosecution of the patent application, for which any compensation or consideration was given or charged, and if so, to disclose the name or names of the person or persons providing such assistance. Assistance includes the preparation for the applicant of the specification and amendments or other papers to be filed in the Patent and Trademark Office, as well as other assistance in such matters, but does not include merely making drawings by draftsmen or stenographic services in typing papers.

(h) *Ratification/confirmation/evidence of authenticity*: The Office may require ratification, confirmation (which includes submission of a duplicate document but with a proper signature), or evidence of authenticity of a signature, such as when the Office has reasonable doubt as to the authenticity (veracity) of the signature, e.g., where there are variations of a signature, or where the signature and the typed or

printed name, do not clearly identify the person signing.

[24 FR 10332, Dec. 22, 1959; 43 FR 20461, May 11, 1978; para. (a), 48 FR 2707, Jan. 20, 1983, effective Feb. 27, 1983; para. (a), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; para. (a)(2), 53 FR 47807, Nov. 28, 1988, effective Jan. 1, 1989; paras. (d)-(f) added, 58 FR 54494, Oct. 22, 1993, effective Nov. 22, 1993; para. (d) revised & para. (g) added, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; paras. (a)(2) and (d)(1) revised, 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; paras. (b) and (c) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a)(2) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; para. (d)(1)(iii)(A) amended, 67 FR 79520, Dec. 30, 2002, effective Dec. 30, 2002; para. (d)(1)(iii)(B) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (d)(1)(iii) removed and reserved, paras. (a)(1), (a)(2), (b), (d)(1), introductory text, and (d)(1)(ii) revised, 68 FR 48286, Aug. 13, 2003, effective Sept. 12, 2003; para. (a)(2) revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; paras. (d) and (e) revised and para. (h) added, 69 FR 56481, Sept. 21, 2004, effective Sept. 21, 2004; para. (d)(2) introductory text and paragraph (d)(2)(ii) revised, 70 FR 56119, Sept. 26, 2005, effective Nov. 25, 2005; paras. (d)(2) introductory text, (d)(3), and (d)(4)(ii) revised, 72 FR 2770, Jan. 23, 2007, effective Jan. 23, 2007; paras. (d)(3) and (d)(4)(i) revised, para. (d)(4)(ii)(C) added, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008]

## § 1.5 Identification of patent, patent application, or patent-related proceeding.

(a) No correspondence relating to an application should be filed prior to receipt of the application number from the Patent and Trademark Office. When a letter directed to the Patent and Trademark Office concerns a previously filed application for a patent, it must identify on the top page in a conspicuous location, the application number (consisting of the series code and the serial number; e.g., 07/123,456), or the serial number and filing date assigned to that application by the Patent and Trademark Office, or the international application number of the international application. Any correspondence not containing such identification will be returned to the sender where a return address is available. The returned correspondence will be accompanied with a cover letter which will indicate to the sender that if the returned correspondence is resubmitted to the Patent and Trademark Office within two weeks of the mail date on the cover

# **EXHIBIT D**

**§ 1.121 Manner of making amendments in applications.**

(a) *Amendments in applications, other than reissue applications.* Amendments in applications, other than reissue applications, are made by filing a paper, in compliance with § 1.52, directing that specified amendments be made.

(b) *Specification.* Amendments to the specification, other than the claims, computer listings (§ 1.96) and sequence listings (§ 1.825), must be made by adding, deleting or replacing a paragraph, by replacing a section, or by a substitute specification, in the manner specified in this section.

(1) *Amendment to delete, replace, or add a paragraph.* Amendments to the specification, including amendment to a section heading or the title of the invention which are considered for amendment purposes to be an amendment of a paragraph, must be made by submitting:

(i) An instruction, which unambiguously identifies the location, to delete one or more paragraphs of the specification, replace a paragraph with one or more replacement paragraphs, or add one or more paragraphs;

(ii) The full text of any replacement paragraph with markings to show all the changes relative to the previous version of the paragraph. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strikethrough cannot be easily perceived;

(iii) The full text of any added paragraphs without any underlining; and

(iv) The text of a paragraph to be deleted must not be presented with strike-through or placed within double brackets. The instruction to delete may identify a paragraph by its paragraph number or include a few words from the beginning, and end, of the paragraph, if needed for paragraph identification purposes.

(2) *Amendment by replacement section.* If the sections of the specification contain section headings as provided in § 1.77(b), § 1.154(b), or § 1.163(c),

amendments to the specification, other than the claims, may be made by submitting:

(i) A reference to the section heading along with an instruction, which unambiguously identifies the location, to delete that section of the specification and to replace such deleted section with a replacement section; and;

(ii) A replacement section with markings to show all changes relative to the previous version of the section. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived.

(3) *Amendment by substitute specification.* The specification, other than the claims, may also be amended by submitting:

(i) An instruction to replace the specification; and

(ii) A substitute specification in compliance with §§ 1.125(b) and (c).

(4) *Reinstatement of previously deleted paragraph or section.* A previously deleted paragraph or section may be reinstated only by a subsequent amendment adding the previously deleted paragraph or section.

(5) *Presentation in subsequent amendment document.* Once a paragraph or section is amended in a first amendment document, the paragraph or section shall not be represented in a subsequent amendment document unless it is amended again or a substitute specification is provided.

(c) *Claims.* Amendments to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the

claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).

(1) *Claim listing.* All of the claims presented in a claim listing shall be presented in ascending numerical order. Consecutive claims having the same status of “canceled” or “not entered” may be aggregated into one statement (e.g., Claims 1–5 (canceled)). The claim listing shall commence on a separate sheet of the amendment document and the sheet(s) that contain the text of any part of the claims shall not contain any other part of the amendment.

(2) *When claim text with markings is required.* All claims being currently amended in an amendment paper shall be presented in the claim listing, indicate a status of “currently amended,” and be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. Only claims having the status of “currently amended,” or “withdrawn” if also being amended, shall include markings. If a withdrawn claim is currently amended, its status in the claim listing may be identified as “withdrawn—currently amended.”

(3) *When claim text in clean version is required.* The text of all pending claims not being currently amended shall be presented in the claim listing in clean version, i.e., without any markings in the presentation of text. The presentation of a clean version of any claim having the status of “original,” “withdrawn” or “previously presented” will constitute an assertion that it has not been changed relative to the immediate prior version, except to omit markings that may have been present in the immediate prior version of the claims of the status of “withdrawn” or “previously presented.” Any claim added by amendment

must be indicated with the status of “new” and presented in clean version, i.e., without any underlining.

(4) *When claim text shall not be presented; canceling a claim.*

(i) No claim text shall be presented for any claim in the claim listing with the status of “canceled” or “not entered.”

(ii) Cancellation of a claim shall be effected by an instruction to cancel a particular claim number. Identifying the status of a claim in the claim listing as “canceled” will constitute an instruction to cancel the claim.

(5) *Reinstatement of previously canceled claim.* A claim which was previously canceled may be reinstated only by adding the claim as a “new” claim with a new claim number.

(d) *Drawings:* One or more application drawings shall be amended in the following manner: Any changes to an application drawing must be in compliance with § 1.84 and must be submitted on a replacement sheet of drawings which shall be an attachment to the amendment document and, in the top margin, labeled “Replacement Sheet”. Any replacement sheet of drawings shall include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is amended. Any new sheet of drawings containing an additional figure must be labeled in the top margin as “New Sheet”. All changes to the drawings shall be explained, in detail, in either the drawing amendment or remarks section of the amendment paper.

(1) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be included. The marked-up copy must be clearly labeled as “Annotated Sheet” and must be presented in the amendment or remarks section that explains the change to the drawings.

(2) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, must be provided when required by the examiner.

(e) *Disclosure consistency.* The disclosure must be amended, when required by the Office, to correct inaccuracies of description and definition, and to secure substantial correspondence between the claims, the remainder of the specification, and the drawings.

(f) *No new matter.* No amendment may introduce new matter into the disclosure of an application.

(g) *Exception for examiner's amendments.* Changes to the specification, including the claims, of an application made by the Office in an examiner's amendment may be made by specific instructions to insert or delete subject matter set forth in the examiner's amendment by identifying the precise point in the specification or the claim(s) where the insertion or deletion is to be made. Compliance with paragraphs (b)(1), (b)(2), or (c) of this section is not required.

(h) *Amendment sections.* Each section of an amendment document (e.g., amendment to the claims, amendment to the specification, replacement drawings, and remarks) must begin on a separate sheet.

(i) *Amendments in reissue applications.* Any amendment to the description and claims in reissue applications must be made in accordance with § 1.173.

(j) *Amendments in reexamination proceedings.* Any proposed amendment to the description and claims in patents involved in reexamination proceedings must be made in accordance with § 1.530.

(k) *Amendments in provisional applications.* Amendments in provisional applications are not usually made. If an amendment is made to a provisional application, however, it must comply with the provisions of this section. Any amendments to a provisional application shall be placed in the provisional application file but may not be entered.

[32 FR 13583, Sept. 28, 1967; 46 FR 29183, May 29, 1981; para. (e), 49 FR 555, Jan. 4, 1984, effective Apr. 1, 1984; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (i) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; revised, 68 FR 38611, June 30, 2003, effective July 30, 2003; para. (d) revised, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004]

**§ 1.122 [Reserved]**

[24 FR 10332, Dec. 22, 1959; para. (b), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

**§ 1.123 [Reserved]**

[48 FR 2712, Jan. 20, 1983, effective Feb. 27, 1983; 49 FR 555, Jan. 4, 1984, effective Apr. 1, 1984; amended, 58 FR 38719, July 20, 1993, effective Oct. 1, 1993; removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

**§ 1.124 [Reserved]**

[Removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

**§ 1.125 Substitute specification.**

(a) If the number or nature of the amendments or the legibility of the application papers renders it difficult to consider the application, or to arrange the papers for printing or copying, the Office may require the entire specification, including the claims, or any part thereof, be rewritten.

(b) Subject to § 1.312, a substitute specification, excluding the claims, may be filed at any point up to payment of the issue fee if it is accompanied by a statement that the substitute specification includes no new matter.

(c) A substitute specification submitted under this section must be submitted with markings showing all the changes relative to the immediate prior version of the specification of record. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. An accompanying clean version (without markings) must also be supplied. Numbering the paragraphs of the specification of record is not considered a change that must be shown pursuant to this paragraph.

(d) A substitute specification under this section is not permitted in a reissue application or in a reexamination proceeding.

[48 FR 2712, Jan. 20, 1983, effective Feb. 27, 1983; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; paras. (b)(2) and (c) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (b) and (c) revised, 68 FR 38611, June 30, 2003, effective July 30, 2003]

# **EXHIBIT E**

### 713.07 Exposure of Other Cases

Prior to an interview in the examiner's room, the examiner should arrange his or her desk so that all files, drawings and other papers, except those necessary in the interview, are placed out of view. See MPEP § 101.

### 713.08 Demonstration, Exhibits, Models [R-3]

The invention in question may be exhibited or demonstrated during the interview by a model >or exhibit< thereof. \*>A model or exhibit will not generally be admitted as part of the record of an application. See 37 CFR 1.91. However, a< model \*\*>or exhibit submitted by< the applicant \*\* which complies with 37 CFR 1.91 \*\*>would be< made part of the application record \*\*. See MPEP § 608.03 and § 608.03(a). For Image File Wrapper (IFW) processing, see IFW Manual section 3.6.

\*\* If the model or exhibit is merely used for demonstration purpose \*\*>during the course of the interview, it will not be< made part of the record (does not comply with 37 CFR 1.91)\*\*>. A< full description as to what was demonstrated/exhibited must be made of record in the application. See 37 CFR 1.133(b). Demonstrations of apparatus or exhibits too large to be brought into the Office may be viewed by the examiner outside of the Office (in the Washington, D.C. area) with the approval of the supervisory patent examiner. It is presumed that the witnessing of the demonstration or the reviewing of the exhibit is actually essential in the developing and clarifying of the issues involved in the application.

### 713.09 Finally Rejected Application

Normally, one interview after final rejection is permitted. However, prior to the interview, the intended purpose and content of the interview should be presented briefly, preferably in writing. Such an interview may be granted if the examiner is convinced that disposal or clarification for appeal may be accomplished with only nominal further consideration. Interviews merely to restate arguments of record or to discuss new limitations which would require more than nominal reconsideration or new search should be denied. See MPEP § 714.13.

Interviews may be held after the expiration of the shortened statutory period and prior to the maximum permitted statutory period of 6 months without an extension of time. See MPEP § 706.07(f).

A second or further interview after a final rejection may be held if the examiner is convinced that it will expedite the issues for appeal or disposal of the application.

### 713.10 Interview Preceding Filing Amendment Under 37 CFR 1.312

After an application is sent to issue, it is technically no longer under the jurisdiction of the primary examiner. 37 CFR 1.312. An interview with an examiner that would involve a detailed consideration of claims sought to be entered and perhaps entailing a discussion of the prior art for determining whether or not the claims are allowable should not be given. Obviously an applicant is not entitled to a greater degree of consideration in an amendment presented informally than is given an applicant in the consideration of an amendment when formally presented, particularly since consideration of an amendment filed under 37 CFR 1.312 cannot be demanded as a matter of right.

Requests for interviews on cases where a notice of allowance has been mailed should be granted only with specific approval of the Technology Center Director upon a showing in writing of extraordinary circumstances.

### 714 Amendments, Applicant's Action [R-6]

*37 CFR 1.121. Manner of making amendments in application.*

(a) *Amendments in applications, other than reissue applications.* Amendments in applications, other than reissue applications, are made by filing a paper, in compliance with § 1.52, directing that specified amendments be made.

(b) *Specification.* Amendments to the specification, other than the claims, computer listings (§ 1.96) and sequence listings (§ 1.825), must be made by adding, deleting or replacing a paragraph, by replacing a section, or by a substitute specification, in the manner specified in this section.

(1) *Amendment to delete, replace, or add a paragraph.* Amendments to the specification, including amendment to a section heading or the title of the invention which are considered for



amendment purposes to be an amendment of a paragraph, must be made by submitting:

(i) An instruction, which unambiguously identifies the location, to delete one or more paragraphs of the specification, replace a paragraph with one or more replacement paragraphs, or add one or more paragraphs;

(ii) The full text of any replacement paragraph with markings to show all the changes relative to the previous version of the paragraph. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strikethrough cannot be easily perceived;

(iii) The full text of any added paragraphs without any underlining; and;

(iv) The text of a paragraph to be deleted must not be presented with strike-through or placed within double brackets. The instruction to delete may identify a paragraph by its paragraph number or include a few words from the beginning, and end, of the paragraph, if needed for paragraph identification purposes.

(2) *Amendment by replacement section.* If the sections of the specification contain section headings as provided in § 1.77(b), § 1.154(b), or § 1.163(c), amendments to the specification, other than the claims, may be made by submitting:

(i) A reference to the section heading along with an instruction, which unambiguously identifies the location, to delete that section of the specification and to replace such deleted section with a replacement section; and;

(ii) A replacement section with markings to show all changes relative to the previous version of the section. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived.

(3) *Amendment by substitute specification.* The specification, other than the claims, may also be amended by submitting:

(i) An instruction to replace the specification; and

(ii) A substitute specification in compliance with §§ 1.125(b) and (c).

(4) *Reinstatement of previously deleted paragraph or section.* A previously deleted paragraph or section may be reinstated only by a subsequent amendment adding the previously deleted paragraph or section.

(5) *Presentation in subsequent amendment document.* Once a paragraph or section is amended in a first amendment document, the paragraph or section shall not be represented in a subsequent amendment document unless it is amended again or a substitute specification is provided.

(c) *Claims.* Amendments to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions)

as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).

(1) *Claim listing.* All of the claims presented in a claim listing shall be presented in ascending numerical order. Consecutive claims having the same status of “canceled” or “not entered” may be aggregated into one statement (e.g., Claims 1–5 (canceled)). The claim listing shall commence on a separate sheet of the amendment document and the sheet(s) that contain the text of any part of the claims shall not contain any other part of the amendment.

(2) *When claim text with markings is required.* All claims being currently amended in an amendment paper shall be presented in the claim listing, indicate a status of “currently amended,” and be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. Only claims having the status of “currently amended,” or “withdrawn” if also being amended, shall include markings. If a withdrawn claim is currently amended, its status in the claim listing may be identified as “withdrawn—currently amended.”

(3) *When claim text in clean version is required.* The text of all pending claims not being currently amended shall be presented in the claim listing in clean version, i.e., without any markings in the presentation of text. The presentation of a clean version of any claim having the status of “original,” “withdrawn” or “previously presented” will constitute an assertion that it has not been changed relative to the immediate prior version, except to omit markings that may have been present in the immediate prior version of the claims of the status of “withdrawn” or “previously presented.” Any claim added by amendment must be indicated with the status of “new” and presented in clean version, i.e., without any underlining.

(4) *When claim text shall not be presented; canceling a claim.*

(i) No claim text shall be presented for any claim in the claim listing with the status of “canceled” or “not entered.”

(ii) Cancellation of a claim shall be effected by an instruction to cancel a particular claim number. Identifying the status of a claim in the claim listing as “canceled” will constitute an instruction to cancel the claim.

(5) *Reinstatement of previously canceled claim.* A claim which was previously canceled may be reinstated only by adding the claim as a "new" claim with a new claim number.

(d) *Drawings:* One or more application drawings shall be amended in the following manner: Any changes to an application drawing must be in compliance with § 1.84 and must be submitted on a replacement sheet of drawings which shall be an attachment to the amendment document and, in the top margin, labeled "Replacement Sheet". Any replacement sheet of drawings shall include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is amended. Any new sheet of drawings containing an additional figure must be labeled in the top margin as "New Sheet". All changes to the drawings shall be explained, in detail, in either the drawing amendment or remarks section of the amendment paper.

(1) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be included. The marked-up copy must be clearly labeled as "Annotated Sheet" and must be presented in the amendment or remarks section that explains the change to the drawings.

(2) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, must be provided when required by the examiner.

(e) *Disclosure consistency.* The disclosure must be amended, when required by the Office, to correct inaccuracies of description and definition, and to secure substantial correspondence between the claims, the remainder of the specification, and the drawings.

(f) *No new matter.* No amendment may introduce new matter into the disclosure of an application.

(g) *Exception for examiner's amendments.* Changes to the specification, including the claims, of an application made by the Office in an examiner's amendment may be made by specific instructions to insert or delete subject matter set forth in the examiner's amendment by identifying the precise point in the specification or the claim(s) where the insertion or deletion is to be made. Compliance with paragraphs (b)(1), (b)(2), or (c) of this section is not required.

(h) *Amendment sections.* Each section of an amendment document (e.g., amendment to the claims, amendment to the specification, replacement drawings, and remarks) must begin on a separate sheet.

(i) *Amendments in reissue applications.* Any amendment to the description and claims in reissue applications must be made in accordance with § 1.173.

(j) *Amendments in reexamination proceedings.* Any proposed amendment to the description and claims in patents involved in reexamination proceedings must be made in accordance with § 1.530.

(k) *Amendments in provisional applications.* Amendments in provisional applications are not usually made. If an amendment is made to a provisional application, however, it must comply with the provisions of this section. Any amendments to a provisional application shall be placed in the provisional application file but may not be entered.

## I. WHEN APPLICANT MAY AMEND

The applicant may amend:

(A) before or after the first examination and action and also after the second or subsequent examination or reconsideration as specified in 37 CFR 1.112;

(B) after final rejection, if the amendment meets the criteria of 37 CFR 1.116;

(C) after the date of filing a notice of appeal pursuant to 37 CFR 41.31(a), if the amendment meets the criteria of 37 CFR 41.33; and

(D) when and as specifically required by the examiner.

Amendments in provisional applications are not normally made. If an amendment is made to a provisional application, however, it must comply with the provisions of 37 CFR 1.121. Any amendments to a provisional application will be placed in the provisional application file, but may not be entered.

## II. MANNER OF MAKING AMENDMENTS UNDER 37 CFR 1.121

All amendments filed on or after July 30, 2003 must comply with 37 CFR 1.121 as revised in the notice of final rule making published in the *Federal Register* on June 30, 2003 at 65 *Fed. Reg.* 38611. The manner of making amendments has been revised to assist in the implementation of beginning-to-end electronic image processing of patent applications. Specifically, changes have been made to facilitate electronic image data capture and processing and streamline the patent application process. If an amendment filed on or after July 30, 2003 does not comply with revised 37 CFR 1.121, the Office will notify applicants via a Notice of Non-Compliant Amendment that the amendment is not accepted.

The revised amendment practice is summarized as follows.

### A. Amendment Sections

Each section of an amendment document (e.g., Specification Amendments, Claim Amendments, Drawing Amendments, and Remarks) must begin on a separate sheet to facilitate separate indexing and electronic scanning of each section of an amendment document for placement in an image file wrapper.

It is recommended that applicants use the following format when submitting amendment papers. The amendment papers should include, in the following order:

(A) a cover sheet, or introductory comments, providing the appropriate application information (e.g., application number, applicant, filing date) and which serves as a table of contents to the amendment document by indicating on what page of the amendment document each of the following sections begin;

(B) a section (must begin on a separate sheet) entitled "Amendments to the Specification" (if there are any amendments to the specification). This section should include all amendments to the specification including amendments to the abstract of the disclosure;

(C) a section (must begin on a separate sheet) entitled "Amendments to the Claims" which includes a complete listing of all claims ever presented in the application (if there are any amendments to the claims);

(D) a section (must begin on a separate sheet) entitled "Amendments to the Drawings" in which all changes to the drawings are discussed (if there are any amendments to the drawings);

(E) a remarks section (must begin on a separate sheet); and

(F) any drawings being submitted including any "Replacement Sheet," "New Sheet," or "Annotated Sheet."

### ***B. Amendments to the Specification***

Amendments to the specification, other than the claims, computer listings (37 CFR 1.96) and sequence listings (37 CFR 1.825), must be made by adding, deleting or replacing a paragraph, by replacing a section, or by a substitute specification. In order to delete, replace or add a paragraph to the specification of an application, the amendment must unambiguously identify the paragraph to be modified either by paragraph number (see MPEP § 608.01), page and line, or any other unambiguous method and be accompanied by any replacement or new paragraph(s). Replacement paragraphs must include markings to show the changes. A separate clean version of any replacement paragraphs is not required. Any new paragraphs must be presented in clean form without any markings (i.e., underlining).

Where paragraph numbering has been included in an application as provided in 37 CFR 1.52(b)(6), applicants can easily refer to a specific paragraph by number when presenting an amendment. If a numbered paragraph is to be replaced by a single paragraph, the added replacement paragraph should be numbered with the same number of the paragraph being replaced. Where more than one paragraph is to replace a single original paragraph, the added paragraphs should be numbered using the number of the original paragraph for the first replacement paragraph, followed by increasing decimal numbers for the second and subsequent added paragraphs, e.g., original paragraph [0071] has been replaced with paragraphs [0071], [0071.1], and [0071.2]. If a numbered paragraph is deleted, the numbering of the subsequent paragraphs should remain unchanged.

37 CFR 1.121(b)(1)(ii) requires that the full text of any replacement paragraph be provided with markings to show all the changes relative to the previous version of the paragraph. The text of any added subject matter must be shown by underlining the added text. The text of any deleted subject matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show the deletion of five or fewer consecutive characters (e.g., [[eroor]]). The term "brackets" set forth in 37 CFR 1.121 means square brackets – [ ], and not parentheses – ( ). The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived (e.g., deletion of the number "4" must be shown as [[4]]). As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strike-through, followed by including and underlining the extra text with the desired change (e.g., ~~number 4~~ as number 14 as). For added paragraphs, 37 CFR 1.121(b)(\*)(>1<)(iii) requires that the full text of any added paragraph(s) be presented in clean form without any underlining. Similarly, under 37 CFR 1.121(b)(\*)(>1<)(iv), a marked up version does not have to be supplied for any deleted paragraph(s). It is sufficient to merely indicate or identify any paragraph that has been deleted. The instruction to delete may identify a paragraph by its paragraph number, page and line number, or include a few words from the

beginning, and end, or the paragraph, if needed for paragraph identification.

Applicants are also permitted to amend the specification by replacement sections (e.g., as provided in 37 CFR 1.77(b), 1.154(b), or 1.163(c)). As with replacement paragraphs, the amended version of a replacement section is required to be provided with markings to show all the changes relative to the previous version of the section. The text of any added subject matter must be shown by underlining the added text. The text of any deleted subject matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show the deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived.

Applicants are also permitted to amend the specification by submitting a substitute specification, provided the requirements of 37 CFR 1.125(b) and (c) are met. Under 37 CFR 1.125, a clean version of the substitute specification, a separate marked up version showing the changes in the specification relative to the previous version, and a statement that the substitute specification contains no new matter are required.

Any previously deleted paragraph or section can only be reinstated by a subsequent amendment presenting the previously deleted subject matter. A direction by applicant to remove a previously entered amendment will not be permitted.

### **C. Amendments to the Claims**

Each amendment document that includes a change to an existing claim, including the deletion of an existing claim, or submission of a new claim, must include a complete listing of all claims ever presented (including previously canceled and non-entered claims) in the application. After each claim number, the status identifier of the claim must be presented in a parenthetical expression, and the text of each claim under examination as well as all withdrawn claims (each with markings if any, to show current changes) must be presented. The listing will serve to replace all prior versions of the claims in the application.

**(A) Status Identifiers:** The current status of all of the claims in the application, including any previously canceled or withdrawn claims, must be given. Status is indicated in a parenthetical expression following

the claim number by one of the following status identifiers: (original), (currently amended), (previously presented), (canceled), (withdrawn), (new), or (not entered). The status identifier (withdrawn – currently amended) is also acceptable for a withdrawn claim that is being currently amended. See paragraph (E) below for acceptable alternative status identifiers.

Claims added by a preliminary amendment must have the status identifier (new) instead of (original), even when the preliminary amendment is present on the filing date of the application and such claim is treated as part of the original disclosure. If applicant files a subsequent amendment, applicant must use the status identifier (previously presented) if the claims are not being amended, or (currently amended) if the claims are being amended, in the subsequent amendment. Claims that are canceled by a preliminary amendment that is present on the filing date of the application are required to be listed and must have the status identifier (canceled) in the preliminary amendment and in any subsequent amendment.

The status identifier (not entered) is used for claims that were previously proposed in an amendment (e.g., after-final) that was denied entry.

>In an amendment submitted in a U.S. national stage application, claims that were present on the international filing date or rectified pursuant to PCT Rule 91 must have the status identifier (original); claims that were amended or added under PCT Article 19 or 34 with effect in the U.S. national stage application must have the status identifier (previously presented); and claims that were canceled pursuant to PCT Article 19 or 34 with effect in the U.S. national stage application must have the status identifier (canceled). If the amendment submitted in the U.S. national stage application is making a change in a claim, the status identifier (currently amended) must be used for that claim.<

For any amendment being filed in response to a restriction or election of species requirement and any subsequent amendment, any claims which are non-elected must have the status identifier (withdrawn). Any non-elected claims which are being amended must have either the status identifier (withdrawn) or (withdrawn – currently amended) and the text of the non-elected claims must be presented with markings to indicate the changes. Any non-elected claims that

are being canceled must have the status identifier (canceled).

**(B) Markings to Show the Changes:** All claims being currently amended must be presented with markings to indicate the changes that have been made relative to the immediate prior version. The changes in any amended claim must be shown by strike-through (for deleted matter) or underlining (for added matter) with 2 exceptions: (1) for deletion of five or fewer consecutive characters, double brackets may be used (e.g., [[error]]); (2) if strike-through cannot be easily perceived (e.g., deletion of number “4” or certain punctuation marks), double brackets must be used (e.g., [[4]]). As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strike-through, followed by including and underlining the extra text with the desired change (e.g., ~~number 4 as~~ number 14 as). An accompanying clean version is not required and should not be presented. Only claims of the status “currently amended” or “withdrawn” will include markings.

Any claims added by amendment must be indicated as “new” and the text of the claim must not be underlined.

**(C) Claim Text:** The text of all pending claims under examination and withdrawn claims must be submitted each time any claim is amended. The text of pending claims not being currently amended, including withdrawn claims, must be presented in clean version, i.e., without any markings. Any claim presented in clean version will constitute an assertion that it has not been changed relative to the immediate prior version except to omit markings that may have been present in the immediate prior version of the claims. A claim being canceled must be indicated as “canceled;” the text of the claim must not be presented. Providing an instruction to cancel is optional. Canceled and not entered claims must be listed by only the claim number and status identifier, without presenting the text of the claims. When applicant submits the text of canceled or not-entered claims in the amendment, the Office may accept such an amendment, if the amendment otherwise complies with 37 CFR 1.121, instead of sending out a notice of non-compliant amendment to reduce the processing time.

**(D) Claim Numbering:** All of the claims in each amendment paper must be presented in ascending

numerical order. Consecutive canceled or not entered claims may be aggregated into one statement (e.g., Claims 1 – 5 (canceled)).

A canceled claim can be reinstated only by a subsequent amendment presenting the claim as a new claim with a new claim number. The original numbering of the claims must be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. For example, when applicant cancels all of the claims in the original specification and adds a new set of claims, the claim listing must include all of the canceled claims with the status identifier (canceled) (the canceled claims may be aggregated into one statement). The new claims must be numbered consecutively beginning with the number next following the highest numbered claim previously presented (whether entered or not) in compliance with 37 CFR 1.126.

Example of listing of claims:

Claims 1-5 (canceled)

Claim 6 (withdrawn): A process for molding a bucket.

Claim 7 (previously presented): A bucket with a handle.

Claim 8 (currently amended): A bucket with a ~~green~~ blue handle.

Claim 9 (withdrawn): The process for molding a bucket of claim 6 using molten plastic material.

Claim 10 (original): The bucket of claim 8 with a wooden handle.

Claim 11 (canceled)

Claim 12 (previously presented): A bucket having a circumferential upper lip.

Claim 13 (not entered)

Claim 14 (new): A bucket with plastic sides and bottom.

**(E) Acceptable Alternative Status Identifiers:**  
To prevent delays in prosecution, the Office will

waive certain provisions of 37 CFR 1.121 and accept alternative status identifiers not specifically set forth in 37 CFR 1.121(c). See *Acceptance of Certain Non-Compliant Amendments Under 37 CFR 1.121(c)*, O.G. (July 5, 2005). Accordingly claim listings that include alternative status identifiers as set forth below may be accepted if the amendment otherwise complies with 37 CFR 1.121.

<u>Status Identifiers Set Forth in 37 CFR 1.121(c)</u>	<u>Acceptable Alternatives</u>
1. Original	Original Claim; and Originally Filed Claim
2. Currently amended	Presently amended; and Currently amended claim
3. Canceled	Canceled without prejudice; Cancel; Canceled; Canceled herein; Previously canceled; Canceled claim; and Deleted
4. Withdrawn	Withdrawn from consideration; Withdrawn – new; Withdrawn claim; and Withdrawn – currently amended
5. Previously presented	Previously amended; Previously added; Previously submitted; and Previously presented claim
6. New	Newly added; and New claim
7. Not entered	Not entered claim

The Office may also accept additional variations of the status identifiers provided in 37 CFR 1.121(c) not listed above if an Office personnel determines that the status of the claims is accurate and clear. When accepting alternative status identifiers, the examiner is

not required to correct the status identifiers using an examiner's amendment. Applicant will not be notified and will not be required to submit a corrective compliant amendment. The examiner does not need to make a statement on the record that the alternative status identifiers have been accepted.

#### ***D. Amendments to the Drawing***

Any changes to an application drawing must comply with 37 CFR 1.84 and must be submitted on a replacement sheet of drawings, even when applicant is only submitting better quality drawings without any substantive changes. Any additional new drawings must be submitted on a new sheet of drawings. The replacement or new sheet of drawings must be an attachment to the amendment document and must be identified in the top margin as "Replacement Sheet." The new drawing sheet must be identified in the top margin as "New Sheet." The replacement drawing sheet must include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is amended. The figure or figure number of the amended drawing(s) must not be labeled as "amended." A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be included. The marked-up copy must be clearly labeled as "Annotated Sheet" and must be presented in the amendment or remarks section that explains the change to the drawings. A marked-up copy of any amended drawing figure, including annotations indicating the changes made, must be provided when required by the examiner.

An explanation of the changes made must be presented in the "Amendments to the Drawings" or the remarks section of the amendment document. If the changes to the drawing figure(s) are not approved by the examiner, applicant will be notified in the next Office action. Applicant must amend the brief and detailed description of drawings sections of the specification if they are not consistent with the changes to the drawings. For example, when applicant files a new drawing sheet, an amendment to the specification is required to add the brief and detailed description of the new drawings.

The proposed drawing correction practice has been eliminated. For any changes to the drawings, applicant is required to submit a replacement sheet of drawings with the changes made. No proposed

changes in red ink should be submitted. Any proposed drawing corrections will be treated as non-compliant under 37 CFR 1.121(d). In response to any drawing objections, applicant should submit drawing changes by filing a replacement sheet of drawings or a new sheet of drawings with the corrections made. A letter to the official draftsman is no longer required.

Drawing submissions without any amendments to the specification and claims after allowance should be forwarded to the Office of Patent Publication.

#### **E. Examiner's Amendments**

37 CFR 1.121(g) permits the Office to make amendments to the specification, including the claims, by examiner's amendments without paragraph/section/claim replacement in the interest of expediting prosecution and reducing cycle time. Additions or deletions of subject matter in the specification, including the claims, may be made by instructions to make the change at a precise location in the specification or the claims. Examiner's amendments do not need to comply with paragraphs (b)(1), (b)(2), or (c) of 37 CFR 1.121. See MPEP § 1302.04.

If a non-compliant amendment would otherwise place the application in condition for allowance, the examiner may enter the non-compliant amendment and provide an examiner's amendment to correct the non-compliance (e.g., an incorrect status identifier). Similarly, if an amendment under 37 CFR 1.312 after allowance is non-compliant under 37 CFR 1.121 and the entry of the amendment would have been otherwise recommended, the examiner may enter the amendment and correct the non-compliance (e.g., an incorrect status identifier) using an examiner's amendment. See subsection "F. Non-Compliant Amendments" for more information on non-compliant amendments. For example, if some of the status identifiers are incorrect in an amendment, the examiner may enter the non-compliant amendment and:

(A) provide a claim listing presenting all of the claims with the proper status identifiers in an examiner's amendment;

(B) print a copy of the claim listing of the non-compliant amendment, cross out the improper status identifiers, write in the correct status identifiers and include it as an attachment to an examiner's amendment; or

(C) correct the improper status identifiers by instructions in an examiner's amendment.

The examiner's amendment should include the reason why the amendment is non-compliant and indicate how it was corrected. Authorization from the applicant or attorney/agent of record and appropriate extensions of time are not required if the changes are not substantive (e.g., corrections of format errors or typographical errors). Such an examiner's amendment may be made after the time period for reply, or after the shortened statutory period without any extensions of time, as long as the non-compliant amendment was timely filed.

Authorization and appropriate extensions of time are required if the changes made in the examiner's amendment are substantive (e.g., the examiner's amendment would include a cancellation of a claim or change the scope of the claims). The authorization must be given within the time period for reply set forth in the last Office action. See MPEP § 1302.04.

#### **F. Non-Compliant Amendments**

If an amendment submitted on or after July 30, 2003, fails to comply with 37 CFR 1.121 (as revised on June 30, 2003), the Office will notify applicant by a Notice of Non-Compliant Amendment, Form PTOL-324, that the amendment fails to comply with the requirements of 37 CFR 1.121 and identify: (1) which section of the amendment is non-compliant (e.g., the amendments to the claims section); (2) items that are required for compliance (e.g., a claim listing in compliance with 37 CFR 1.121(c)); and (3) the reasons why the section of the amendment fails to comply with 37 CFR 1.121 (e.g., the status identifiers are missing). The type of amendment will determine whether applicant will be given a period of time in which to comply with the rule and whether applicant's reply to a notice should consist of the corrected section of the amendment (e.g., a complete claim listing in compliance of 37 CFR 1.121(c)) instead of the entire corrected amendment. If the noncompliant amendment is:

(A) A preliminary amendment filed after the filing date of the application, the technical support staff (TSS) will send the notice which sets a time period of 30 days or one month, whichever is later, for reply. No extensions of time are permitted. Failure to



submit a timely reply will result in the application being examined without entry of the preliminary amendment. Applicant's reply is required to include the corrected section of the amendment.

(B) A **preliminary amendment that is present on the filing date of the application**, the Office of Initial Patent Examination (OIPE) will send applicant a notice (e.g., Notice to File Corrected Application Papers) which sets a time period of 2 months for reply. Extensions of time are available under 37 CFR 1.136(a). Failure to reply to the OIPE notice will result in abandonment of the application. Applicant's reply is required to include either a substitute specification under 37 CFR 1.125 if the amendment is to the specification, or a complete claim listing under 37 CFR 1.121(c) if the amendment is to the claims.

(C) A **non-final amendment** including an amendment filed as a submission for an RCE, the TSS will send the notice which sets a time period of 30 days or one month, whichever is later, for reply. Extensions of time are available under 37 CFR 1.136(a). Failure to reply to this notice will result in abandonment of the application. Applicant's reply is required to include the corrected section of the amendment.

(D) An **after-final amendment**, the amendment will be forwarded in unentered status to the examiner. In addition to providing reasons for non-entry when the amendment is not in compliance with 37 CFR 1.116 (e.g., the proposed amendment raises new issues that would require further consideration and/or search), the examiner should also indicate in the advisory action any non-compliance in the after-final amendment. The examiner should attach a Notice of Non-Compliant Amendment to the advisory action. The notice provides no new time period for correcting the non-compliance. The time period for reply continues to run from the mailing of the final Office action. Applicant still needs to respond to the final Office action to avoid abandonment of the application. If the applicant wishes to file another after-final amendment, the entire corrected amendment (not only the corrected section of the amendment) must be submitted within the time period set forth in the final Office action.

(E) A **supplemental amendment filed when there is no suspension of action** under 37 CFR 1.103(a) or (c), the amendment will be forwarded to

the examiner. Such a supplemental amendment is not entered as a matter of right. See 37 CFR 1.111(a)(2)(ii). The examiner will notify the applicant if the amendment is not approved for entry. The examiner may use form paragraph 7.147. See MPEP § 714.03(a).

(F) A **supplemental amendment filed within a suspension period** under 37 CFR 1.103(a) or (c) (e.g., applicant requested a suspension of action at the time of filing an RCE), the TSS will send the notice which sets a time period of 30 days or one month, whichever is later, for reply. No extensions of time are permitted. Failure to submit a timely reply will result in the application being examined without entry of the supplemental amendment. Applicant's reply is required to include the corrected section of the amendment.

(G) An **amendment filed in response to a Quayle action**, the TSS will send the notice which sets a time period of 30 days or one month, whichever is later, for reply. Extensions of time are available under 37 CFR 1.136(a). Failure to reply to this notice will result in abandonment of the application. Applicant's reply is required to include the corrected section of the amendment.

(H) An **after-allowance amendment** under 37 CFR 1.312, the amendment will be forwarded to the examiner. Amendments under 37 CFR 1.312 are not entered as matter of right. The examiner will notify the applicant if the amendment is not approved for entry. The examiner may attach a Notice of Non-Compliant Amendment (37 CFR 1.121) to the form PTO-271, Response to Rule 312 Communication (see MPEP § 714.16(d)). The notice provides no new time period. If applicant wishes to file another after-allowance amendment under 37 CFR 1.312, the entire corrected amendment must be submitted before the payment of the issue fee.

Any amendments (including after-final amendments) that add new claims in excess of the number of claims previously paid for in an application must be accompanied by the payment of the required excess claims fees. Failure to pay the excess claims fees will result in non-entry of the amendment. See MPEP § 607.



**G. *Entry of Amendments, Directions for, Defective***

The directions for the entry of an amendment may be defective. Examples include inaccuracy in the paragraph number and/or page and line designated, or a lack of precision where the paragraph or section to which insertion of the amendment is directed occurs. If the correct place of entry is clear from the context, the amendatory paper will be properly amended in the Technology Center and notation thereof, initialed in ink by the examiner, who will assume full responsibility for the change, will be made on the margin of the amendatory paper. In the next Office action, the applicant should be informed of this alteration in the amendment and the entry of the amendment as thus amended. The applicant will also be informed of the

nonentry of an amendment where defective directions and context leave doubt as to the intent of applicant.

**H. *Amendment of Amendments***

When a replacement paragraph or section of the specification is to be amended, it should be wholly rewritten and the original insertion canceled. A marked-up version of the replacement paragraph or section of the specification should be presented using underlining to indicate added subject matter and strike-through to indicate deleted subject matter. Matter canceled by amendment can be reinstated only by a subsequent amendment presenting the canceled matter as a new insertion. A claim cancelled by amendment (deleted in its entirety) may be reinstated only by a subsequent amendment presenting the claim as a new claim with a new claim number.

<b>Notice of Non-Compliant Amendment (37 CFR 1.121)</b>	Application No.	Applicant(s)	
	Examiner	Art Unit	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

The amendment document filed on \_\_\_\_\_ is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121 or 1.4. In order for the amendment document to be compliant, correction of the following item(s) is required.

**THE FOLLOWING MARKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:**

- ☐ 1. Amendments to the specification:
  - ☐ A. Amended paragraph(s) do not include markings.
  - ☐ B. New paragraph(s) should not be underlined.
  - ☐ C. Other \_\_\_\_\_.
- ☐ 2. Abstract:
  - ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
  - ☐ B. Other \_\_\_\_\_.
- ☐ 3. Amendments to the drawings:
  - ☐ A. The drawings are not properly identified in the top margin as "Replacement Sheet," "New Sheet," or "Annotated Sheet" as required by 37 CFR 1.121(d).
  - ☐ B. The practice of submitting proposed drawing correction has been eliminated. Replacement drawings showing amended figures, without markings, in compliance with 37 CFR 1.84 are required.
  - ☐ C. Other \_\_\_\_\_.
- ☐ 4. Amendments to the claims:
  - ☐ A. A complete listing of all of the claims is not present.
  - ☐ B. The listing of claims does not include the text of all pending claims (including withdrawn claims)
  - ☐ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified. Note: the status of every claim must be indicated after its claim number by using one of the following status identifiers: (Original), (Currently amended), (Canceled), (Previously presented), (New), (Not entered), (Withdrawn) and (Withdrawn-currently amended).
  - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
  - ☐ E. Other: \_\_\_\_\_.
- ☐ 5. Other (e.g., the amendment is unsigned or not signed in accordance with 37 CFR 1.4): \_\_\_\_\_

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP § 714.

**TIME PERIODS FOR FILING A REPLY TO THIS NOTICE:**

1. Applicant is given **no new time period** if the non-compliant amendment is an after-final amendment or an amendment filed after allowance. If applicant wishes to resubmit the non-compliant after-final amendment with corrections, the **entire corrected amendment** must be resubmitted.
2. Applicant is given **one month**, or thirty (30) days, whichever is longer, from the mail date of this notice to supply the correction, if the non-compliant amendment is one of the following: a preliminary amendment, a non-final amendment (including a submission for a request for continued examination (RCE) under 37 CFR 1.114), a supplemental amendment filed within a suspension period under 37 CFR 1.103(a) or (c), and an amendment filed in response to a *Quayle* action. If any of above boxes 1. to 4. are checked, the correction required is only the **corrected section** of the non-compliant amendment in compliance with 37 CFR 1.121.

**Extensions of time** are available under 37 CFR 1.136(a) only if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action.

**Failure to timely respond** to this notice will result in:

- Abandonment** of the application if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action; or
- Non-entry** of the amendment if the non-compliant amendment is a preliminary amendment or supplemental amendment.

Legal Instruments Examiner (LIE), if applicable	Telephone No.
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U.S. Patent and Trademark Office  
PTOL-324 (01-06)

Notice of Non-Compliant Amendment (37 CFR 1.121)

Part of Paper No.

### III. AMENDMENT IN REEXAMINATION PROCEEDINGS AND REISSUE APPLICATIONS

Amendments in reissue applications must be made in accordance with 37 CFR 1.173. Amendments in *ex parte* and *inter partes* reexamination proceedings must be made in accordance with 37 CFR 1.530. In patent-owner-filed *ex parte* reexaminations, the patent owner may amend at the time of the request for *ex parte* reexamination in accordance with 37 CFR 1.510(e). In any *ex parte* reexamination proceeding, no amendment or response can be filed between the date of the request for *ex parte* reexamination and the order for *ex parte* reexamination. See 37 CFR 1.530(a). Following the order for *ex parte* reexamination under 37 CFR 1.525 and prior to the examination phase of *ex parte* reexamination proceeding, an amendment may be filed only with the patent owner's statement under 37 CFR 1.530(b). During the examination phase of the *ex parte* reexamination proceeding, an amendment may be filed:

(A) after the first examination as specified in 37 CFR 1.112;

(B) after final rejection or an appeal has been taken, if the amendment meets the criteria of 37 CFR 1.116; and

(C) when and as specifically required by the examiner.

See also MPEP § 714.12.

For amendments in *ex parte* reexamination proceedings see MPEP § 2250 and § 2266. For amendments by patent owner in an *inter partes* reexamination proceeding, see MPEP § 2666.01 and § 2672. For amendments in reissue applications, see MPEP § 1453.

#### 714.01 Signatures to Amendments

An amendment must be signed by a person having authority to prosecute the application. An unsigned or improperly signed amendment will not be entered. See MPEP § 714.01(a).

To facilitate any telephone call that may become necessary, it is recommended that the complete telephone number with area code and extension be given, preferably near the signature.

#### 714.01(a) Unsigned or Improperly Signed Amendment [R-3]

37 CFR 1.33. Correspondence respecting patent applications, reexamination proceedings, and other proceedings.

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(b) *Amendments and other papers.* Amendments and other papers, except for written assertions pursuant to § 1.27(c)(2)(ii) of this part, filed in the application must be signed by:

(1) A registered patent attorney or patent agent of record appointed in compliance with § 1.32(b);

(2) A registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34;<

(3) An assignee as provided for under § 3.71(b) of this chapter; or

(4) All of the applicants (§ 1.41(b)) for patent, unless there is an assignee of the entire interest and such assignee has taken action in the application in accordance with § 3.71 of this chapter.

\*\*\*\*\*

An unsigned amendment or one not properly signed by a person having authority to prosecute the application is not entered. This applies, for instance, where the amendment is signed by only one of two applicants and the one signing has not been given a power of attorney by the other applicant.

\*\*

When an unsigned or improperly signed amendment is received the amendment will be listed in the contents of the application file, but not entered. The examiner will notify applicant of the status of the application, advising him or her to furnish a duplicate amendment properly signed or to ratify the amendment already filed. In an application not under final rejection, applicant should be given a 1-month time period in which to ratify the previously filed amendment (37 CFR 1.135(c)).

Applicants may be advised of unsigned amendments by use of form paragraph 7.84.01.

##### ¶ 7.84.01 Paper Is Unsigned

The proposed reply filed on [1] has not been entered because it is unsigned. Since the above-mentioned reply appears to be *bona fide*, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Sometimes problems arising from unsigned or improperly signed amendments may be disposed of by calling in the local representative of the attorney or agent of record, since he or she may have the authority to sign the amendment.

An amendment signed by a person whose name is known to have been removed from the registers of attorneys and agents under the provisions of 37 CFR 10.11 is not entered. The file and unentered amendment are submitted to the Office of Enrollment and Discipline for appropriate action.

### **714.01(c) Signed by Attorney or Agent Not of Record**

See MPEP § 405. A registered attorney or agent acting in a representative capacity under 37 CFR 1.34, may sign amendments even though he or she does not have a power of attorney in the application. See MPEP § 402.

### **714.01(d) Amendment Signed by Applicant but Not by Attorney or Agent of Record**

If an amendment signed by the applicant is received in an application in which there is a duly appointed attorney or agent, the amendment should be entered and acted upon. Attention should be called to 37 CFR 1.33(a) in patent applications and to 37 CFR 1.33(c) in reexamination proceedings. Two copies of the action should be prepared, one being sent to the attorney and the other directly to the applicant. The notation: "Copy to applicant" should appear on the original and on both copies.

### **714.01(e) Amendments Before First Office Action [R-5]**

#### ***37 CFR 1.115. Preliminary amendments.***

(a) A preliminary amendment is an amendment that is received in the Office (§ 1.6) on or before the mail date of the first Office action under § 1.104. The patent application publication may include preliminary amendments (§ 1.215 (a)).

(1) A preliminary amendment that is present on the filing date of an application is part of the original disclosure of the application.

(2) A preliminary amendment filed after the filing date of the application is not part of the original disclosure of the application.

\*\*\*\*\*

A preliminary amendment is an amendment that is received in the Office on or before the mail date of the first Office action under 37 CFR 1.104. See 37 CFR 1.115(a). For applications filed on or after September 21, 2004 (the effective date of 37 CFR 1.115(a)(1)), a preliminary amendment that is present on the filing date of the application is part of the original disclosure of the application. For applications filed before September 21, 2004, a preliminary amendment that is present on the filing date of the application is part of the original disclosure of the application if the preliminary amendment was referred to in the first executed oath or declaration under 37 CFR 1.63 filed in the application. See MPEP § 602. Any amendment filed after the filing date of the application is not part of the original disclosure of the application. See MPEP § 706.03(o) regarding new matter. When the Office publishes the application under 35 U.S.C. 122(b), the Office may include preliminary amendments in the patent application publication. See MPEP § 1121.

>If a preliminary amendment is filed in a format that cannot be included in the publication, the Office of Initial Patent Examination (OIPE) will issue a notice to the applicant requiring the applicant to submit the amendment in a format usable for publication purposes. See 37 CFR 1.115(a)(1) and 1.215. The only format for an amendment to the specification (other than the claims) that is usable for publication is a substitute specification in compliance with 37 CFR 1.121(b)(3) and 1.125. As a result, the Office has revised its procedures to mail a notice (e.g., "Notice to File Corrected Application Papers") requiring a substitute specification in compliance with 37 CFR 1.121(b)(3) and 1.125, if an applicant included a preliminary amendment to the specification (other than the claims) on filing. Where applicant wishes to make a specific reference to a prior application as required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a), the specific reference can be submitted in an application data sheet (ADS) under 37 CFR 1.76 rather than in a preliminary amendment to the first sentence(s) of the specification. See 37 CFR 1.78(a)(2)(iii) and (5)(iii). If the specific reference is submitted in a preliminary amendment, however, a substitute specification will

not be required if the preliminary amendment only adds or amends a benefit claim to a prior-filed application under 35 U.S.C. 120, 121, 365(c), or 119(e). If an applicant receives a notice from OIPE (e.g., "Notice to File Corrected Application Papers") requiring a substitute specification because a preliminary amendment was filed that only adds or amends a benefit claim, applicant may reply to the notice explaining that a substitute specification should not have been required because the amendment was only to add or amend a benefit claim. In order to avoid abandonment, applicant should file a reply with the required substitute specification or an explanation that the substitute specification is not necessary because the preliminary amendment only adds or amends a benefit claim. If the preliminary amendment contains other amendments to the specification (other than the claims), a substitute specification will be required, and a reply to a notice requiring a substitute specification without the substitute specification will be treated as an incomplete reply with no new time period for reply being provided.

Requiring a substitute specification (with all preliminary amendments made therein) is also important to ensure that applicants do not circumvent the limitations upon redacted publications set forth in 35 U.S.C. 122(b)(2)(B)(v). As preliminary amendments to the specification, excluding the claims, cannot be easily published, the Office must require a substitute specification whenever an application is filed with a preliminary amendment to the specification, excluding the claims, in order to ensure that the application, including any new matter added by way of a preliminary amendment included on the filing date of the application, is published.

Because a preliminary amendment to the claims or abstract in compliance with 37 CFR 1.121(c) or 1.121(b)(2) will include a complete claim listing or replacement abstract, the Office can publish the amended claims or the replacement abstract as submitted in the preliminary amendment without a substitute specification being filed. Applicants should note, however, that there is no need to file a preliminary amendment to the claims on filing. By making the new claim set part of the originally filed specification, applicant may avoid having to pay an application size fee, as both the specification (including the claims) and any preliminary amendment are used in

counting the number of pages for purposes of 37 CFR 1.16(s). The claim set submitted should be the set of claims intended to be examined, and when the claims submitted on filing are part of the specification (on sequentially numbered pages of the specification (see 37 CFR 1.52(b)(5))), no status identifiers and no markings showing the changes need to be used.

A preliminary amendment filed with a submission to enter the national stage of an international application under 35 U.S.C. 371 is not part of the original disclosure under 37 CFR 1.115(a) because it was not present on the international filing date accorded to the application under PCT Article 11. See MPEP § 1893.03(b). Accordingly, a "Notice to File Corrected Application Papers" requiring a substitute specification will not ordinarily be mailed in an international application even if the national stage submission includes a preliminary amendment.<

Since a request for continued examination (RCE) is not a new application, an amendment filed before the first Office action after the filing of the RCE is not a preliminary amendment. See MPEP § 706.07(h). Any amendment canceling claims in order to reduce the excess claims fees should be filed before the expiration of the time period set forth in a notice that requires excess claims fees. Such an amendment would be effective to reduce the number of claims to be considered in calculating the excess claims fees. See MPEP § 607.

#### **I. PRELIMINARY AMENDMENTS MUST COMPLY WITH 37 CFR 1.121**

Any preliminary amendment, regardless of when it is filed, must comply with 37 CFR 1.121, e.g., the preliminary amendment must include a complete listing of all of the claims and each section of the amendment must begin on a separate sheet of paper. See MPEP § 714. Preliminary amendments made in a transmittal letter of the application will not comply with 37 CFR 1.121. For example, applicants should include the reference to a prior filed application in the first sentence(s) of the specification following the title or in an application data sheet in compliance with 37 CFR 1.78 instead of submitting the reference in a preliminary amendment in a transmittal letter. See MPEP § 201.11. If a preliminary amendment filed after the filing date of the application fails to comply with 37 CFR 1.121, applicant will be notified by way of a

Notice of Non-Compliant Amendment and given a non-extendable period of one month to bring the amendment into compliance with 37 CFR 1.121. If the applicant takes no corrective action, examination of the application will commence without consideration of the proposed changes in the non-compliant preliminary amendment. If a preliminary amendment that is present on the filing date of the application fails to comply with 37 CFR 1.121, the Office of Initial Patent Examination (OIPE) will notify applicant of the non-compliance and give a two-month time period to correct the non-compliance to avoid the abandonment of the application. See MPEP § 714.

Filing a preliminary amendment is not recommended because the changes made by the preliminary amendment may not be reflected in the patent application publication even if the preliminary amendment is referred to in an oath or declaration. If there is insufficient time to have the preliminary amendment be entered into the Office file wrapper of the application before technical preparations for publication of the application have begun, the preliminary amendment will not be reflected in the patent application publication. Technical preparations for publication of an application generally begin four months prior to the projected date of publication. For more information on publication of applications, see MPEP § 1121. Applicants may avoid preliminary amendments by incorporating any desired amendments into the text of the specification including a new set of claims, even where the application is a continuation or divisional application of a previously filed patent application. In such a continuation or divisional application, a clean copy of a specification (i.e., reflecting amendments made in the parent application) may be submitted together with a copy of the oath or declaration from the previously filed application so long as no new matter is included in the specification. See 37 CFR 1.63(d)(1)(iii) and MPEP § 201.06(c).

## **II. PRELIMINARY AMENDMENTS PRESENT ON THE FILING DATE OF THE APPLICATION**

For applications filed on or after September 21, 2004 (the effective date of 37 CFR 1.115(a)(1)), a preliminary amendment that is present on the filing date of the application is part of the original disclosure of the application. For applications filed before Septem-

ber 21, 2004, a preliminary amendment that is present on the filing date of the application is part of the original disclosure of the application if the preliminary amendment was referred to in the first executed oath or declaration under 37 CFR 1.63 filed in the application. See MPEP § 602 and § 608.04(b).

If a preliminary amendment is present on the filing date of an application, and the oath or declaration under 37 CFR 1.63 does not refer to the preliminary amendment, the normal operating procedure is to not screen the preliminary amendment to determine whether it contains subject matter not otherwise included in the specification or drawings of the application as filed (i.e., subject matter that is “new matter” relative to the specification and drawings of the application). As a result, it is applicant’s obligation to review the preliminary amendment to ensure that it does not contain subject matter not otherwise included in the specification or drawings of the application as filed. If the preliminary amendment contains subject matter not otherwise included in the specification and drawings of the application, applicant must provide a supplemental oath or declaration under 37 CFR 1.67 referring to such preliminary amendment. The failure to submit a supplemental oath or declaration under 37 CFR 1.67 referring to a preliminary amendment that contains subject matter not otherwise included in the specification or drawings of the application as filed removes safeguards that are implied in the oath or declaration requirements that the inventor review and understand the contents of the application, and acknowledge the duty to disclose to the Office all information known to be material to patentability as defined in 37 CFR 1.56.

Applicants can avoid the need to file an oath or declaration referring to any preliminary amendment by incorporating any desired amendments into the text of the specification including a new set of claims when filing the application instead of filing a preliminary amendment, even where the application is a continuation or divisional application of a prior-filed application. Furthermore, applicants are strongly encouraged to avoid submitting any preliminary amendments so as to minimize the burden on the Office in processing preliminary amendments and reduce delays in processing the application. During examination, if an examiner determines that a preliminary amendment that is present on the filing date of the application

includes subject matter not otherwise supported by the originally filed specification and drawings, and the oath or declaration does not refer to the preliminary amendment, the examiner may require the applicant to file a supplemental oath or declaration under 37 CFR 1.67 referring to the preliminary amendment. In response to the requirement, applicant must submit (1) an oath or declaration that refers to the preliminary amendment, (2) an amendment that cancels the subject matter not supported by the originally filed specification and drawings, or (3) a request for reconsideration.

For applications filed prior to September 21, 2004, a preliminary amendment that is present on the filing date of an application may be considered a part of the original disclosure if it is referred to in a first filed oath or declaration in compliance with 37 CFR 1.63. If the preliminary amendment was not referred to in the oath or declaration, applicant will be required to submit a supplemental oath or declaration under 37 CFR 1.67 referring to both the application and the preliminary amendment filed with the original application. A surcharge under 37 CFR 1.16(f) will also be required unless it has been previously paid.

### III. PRELIMINARY AMENDMENTS MUST BE TIMELY

Any preliminary amendments should either accompany the application or be filed after the application has received its application number and filing date so that the preliminary amendments would include the appropriate identifications (e.g., the application number and filing date). See MPEP § 502. Any amendments filed after the mail date of the first Office action is not a preliminary amendment. If the date of receipt (37 CFR 1.6) of the amendment is later than the mail date of the first Office action and is not responsive to the first Office action, the Office will not mail a new Office action, but simply advise the applicant that the amendment is nonresponsive to the first Office action and that a responsive reply must be timely filed to avoid abandonment. See MPEP § 714.03.

### IV. PRELIMINARY AMENDMENTS MAY BE DISAPPROVED

37 CFR 1.115. *Preliminary amendments.*

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(b) A preliminary amendment in compliance with § 1.121 will be entered unless disapproved by the Director.

(1) A preliminary amendment seeking cancellation of all the claims without presenting any new or substitute claims will be disapproved.

(2) A preliminary amendment may be disapproved if the preliminary amendment unduly interferes with the preparation of a first Office action in an application. Factors that will be considered in disapproving a preliminary amendment include:

(i) The state of preparation of a first Office action as of the date of receipt (§ 1.6) of the preliminary amendment by the Office; and

(ii) The nature of any changes to the specification or claims that would result from entry of the preliminary amendment.

(3) A preliminary amendment will not be disapproved under (b)(2) of this section if it is filed no later than:

(i) Three months from the filing date of an application under § 1.53 (b);

(ii) The filing date of a continued prosecution application under § 1.53 (d); or

(iii) Three months from the date the national stage is entered as set forth in § 1.491 in an international application.

(4) The time periods specified in paragraph (b)(3) of this section are not extendable.

A preliminary amendment filed in compliance with 37 CFR 1.121 will be entered unless it is disapproved by the Director. A preliminary amendment will be disapproved by the Director if the preliminary amendment cancels all the claims in the application without presenting any new or substitute claims. A preliminary amendment may also be disapproved by the Director if the preliminary amendment unduly interferes with the preparation of an Office action. 37 CFR 1.115(b).

#### A. *Cancellations of All the Claims*

If applicant files a preliminary amendment (whether submitted prior to, on or after the filing date of the application) seeking cancellation of all claims in the application without presenting any new claims, the Office will not enter such an amendment. See *Exxon Corp. v. Phillips Petroleum Co.*, 265 F.3d 1249, 60 USPQ2d 1369 (Fed. Cir. 2001), 37 CFR 1.115(b)(1), and MPEP § 601.01(e). Thus, the application will not be denied a filing date merely because

such a preliminary amendment was submitted on filing. For fee calculation purposes, the Office will treat such an application as containing only a single claim. In most cases, an amendment that cancels all the claims in the application without presenting any new claims would not meet the requirements of 37 CFR 1.121(c) that requires a complete claim listing. See MPEP § 714. The Office will send a notice of non-compliant amendment (37 CFR 1.121) to applicant and require an amendment in compliance with 37 CFR 1.121.

***B. Unduly Interferes With the Preparation of an Office Action***

Once the examiner has started to prepare a first Office action, entry of a preliminary amendment may be disapproved if the preliminary amendment unduly interferes with the preparation of the first Office action. Applicants are encouraged to file all preliminary amendments as soon as possible. Entry of a preliminary amendment will not be disapproved under 37 CFR 1.115(b)(2) if it is filed no later than:

(A) 3 months from the filing date of the application under 37 CFR 1.53(b);

(B) 3 months from the date the national stage is entered as set forth in 37 CFR 1.491 in an international application;

(C) the filing date of a CPA under 37 CFR 1.53(d) in a design application; or

(D) the last day of any suspension period requested by applicant under 37 CFR 1.103 (see MPEP § 709).

Even if the examiner has spent a significant amount of time preparing the first Office action, entry of a preliminary amendment filed within these time periods should not be disapproved under 37 CFR 1.115(b)(2). These time periods are not extendable. See 37 CFR 1.115(b)(4).

If a preliminary amendment is filed after these time periods and the conditions set forth below are met, entry of the preliminary amendment may be denied subject to the approval of the supervisory patent examiner (MPEP § 1002.02(d)).

**1. When Disapproval is Appropriate**

The factors that will be considered for denying entry of preliminary amendments under 37 CFR 1.115 include:

(A) The state of preparation of a first Office action as of the date of receipt (37 CFR 1.6) of the preliminary amendment; and

(B) The nature of any changes to the specification or claims that would result from entry of the preliminary amendment.

The entry of a preliminary amendment that would unduly interfere with the preparation of an Office action may be denied if the following two conditions are met:

(A) the examiner has devoted a significant amount of time on the preparation of an Office action before the amendment is received in the Office (i.e., the 37 CFR 1.6 receipt date of the amendment); and

(B) the entry of the amendment would require significant additional time in the preparation of the Office action.

For example, if the examiner has spent a significant amount of time to conduct a prior art search or draft an Office action before a preliminary amendment is received by the Office, the first condition is satisfied. Entry of the amendment may be denied if it:

(A) amends the claims;

(B) adds numerous new claims;

(C) amends the specification to change the scope of the claims;

(D) amends the specification so that a new matter issue would be raised;

(E) includes arguments;

(F) includes an affidavit or declaration under 37 CFR 1.131 or 37 CFR 1.132; or

(G) includes evidence traversing rejections from a prior Office action in the parent application,

and would require the examiner to spend significant additional time to conduct another prior art search or revise the Office action (i.e., the second condition is satisfied). This list is not an exhaustive list, and the entry of a preliminary amendment may be denied in other situations that satisfy the two conditions set forth above. Once these conditions are met, the



examiner should obtain the approval of the SPE before the entry of the amendment may be denied.

## 2. When Disapproval is Inappropriate

Denying entry of a preliminary amendment under 37 CFR 1.115(b)(2) is inappropriate if either:

(A) the examiner has NOT devoted a significant amount of time on the preparation of an Office action before the amendment is received in the Office (i.e., the 37 CFR 1.6 receipt date of the amendment); or

(B) the entry of the amendment would NOT require significant additional time in the preparation of the Office action.

Thus, the amendment will be entered unless it is denied entry for other reasons such as those listed in MPEP § 714.19.

For example, if before the preliminary amendment is received in the Office, the examiner has not started working on the Office action or has started, but has merely inspected the file for formal requirements, then the examiner should enter and consider the preliminary amendment.

Furthermore, even if the examiner has devoted a significant amount of time to prepare an Office action prior to the date the preliminary amendment is received in the Office, it is not appropriate to disapprove the entry of such an amendment if it:

(A) merely cancels some of the pending claims;

(B) amends the claims to overcome rejections under 35 U.S.C. 112, second paragraph;

(C) amends the claims to place the application in condition for allowance; or

(D) only includes changes that were previously suggested by the examiner, and would not require the examiner to spend significant additional time to revise the Office action.

## 3. Form Paragraph

Form paragraph 7.46 should be used to notify applicant that the entry of a preliminary amendment is denied because the amendment unduly interferes with the preparation of an Office action.

### ¶ 7.46 Preliminary Amendment Unduly Interferes with the Preparation of an Office Action

The preliminary amendment filed on [1] was not entered because entry of the amendment would unduly interfere with the preparation of the Office action. See 37 CFR 1.115(b)(2). The

examiner spent a significant amount of time on the preparation of an Office action before the preliminary amendment was received. On the date of receipt of the amendment, the examiner had completed [2].

Furthermore, entry of the preliminary amendment would require significant additional time on the preparation of the Office action. Specifically, entry of the preliminary amendment would require the examiner to [3].

A responsive reply (under 37 CFR 1.111 or 37 CFR 1.113 as appropriate) to this Office action must be timely filed to avoid abandonment.

If this is not a final Office action, applicant may wish to resubmit the amendment along with a responsive reply under 37 CFR 1.111 to ensure proper entry of the amendment.

### Examiner Note:

1. In bracket 1, provide the date that the Office received the preliminary amendment (use the date of receipt under 37 CFR 1.6, not the certificate of mailing date under 37 CFR 1.8).

2. In bracket 2, provide an explanation on the state of preparation of the Office action as of the receipt date of the preliminary amendment. For example, where appropriate insert --the claim analysis and the search of prior art of all pending claims-- or --the drafting of the Office action and was waiting for the supervisory patent examiner's approval--.

3. In bracket 3, provide a brief explanation of how entry of the preliminary amendment would require the examiner to spend significant additional time in the preparation of the Office action. For example, where appropriate insert --conduct prior art search in another classification area that was not previously searched and required-- or --revise the Office action extensively to address the new issues raised and the new claims added in the preliminary amendment--.

## 714.02 Must Be Fully Responsive [R-3]

*37 CFR 1.111. Reply by applicant or patent owner to a non-final Office action.*

(a)(1) If the Office action after the first examination (§ 1.104) is adverse in any respect, the applicant or patent owner, if he or she persists in his or her application for a patent or reexamination proceeding, must reply and request reconsideration or further examination, with or without amendment. See §§ 1.135 and 1.136 for time for reply to avoid abandonment.

**\*\*>**

(2) *Supplemental replies.* (i) A reply that is supplemental to a reply that is in compliance with § 1.111(b) will not be entered as a matter of right except as provided in paragraph (a)(2)(ii) of this section. The Office may enter a supplemental reply if the supplemental reply is clearly limited to:

(A) Cancellation of a claim(s);

(B) Adoption of the examiner suggestion(s);

(C) Placement of the application in condition for allowance;

(D) Reply to an Office requirement made after the first reply was filed;

(E) Correction of informalities (e.g., typographical errors); or

(F) Simplification of issues for appeal.

(ii) A supplemental reply will be entered if the supplemental reply is filed within the period during which action by the Office is suspended under § 1.103(a) or (c).<

(b) In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a *bona fide* attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.

(c) In amending in reply to a rejection of claims in an application or patent under reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. The applicant or patent owner must also show how the amendments avoid such references or objections.

In all cases where reply to a requirement is indicated as necessary for further consideration of the claims, or where allowable subject matter has been indicated in an application, a complete reply must either comply with the formal requirements or specifically traverse each one not complied with.

Drawing and specification corrections, presentation of a new oath and the like are generally considered as formal matters, although the filing of drawing corrections in reply to an objection to the drawings cannot normally be held in abeyance. However, the line between formal matter and those touching the merits is not sharp, and the determination of the merits of an application may require that such corrections, new oath, etc., be insisted upon prior to any indication of allowable subject matter.

The claims may be amended by canceling particular claims, by presenting new claims, or by rewriting particular claims as indicated in 37 CFR 1.121(c). The requirements of 37 CFR 1.111(b) must be complied

with by pointing out the specific distinctions believed to render the claims patentable over the references in presenting arguments in support of new claims and amendments.

An amendment submitted after a second or subsequent non-final action on the merits which is otherwise responsive but which increases the number of claims drawn to the invention previously acted upon is not to be held not fully responsive for that reason alone. (See 37 CFR 1.112, MPEP § 706.)

The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP § 2163.06.

An amendment which does not comply with the provisions of 37 CFR 1.121(b), (c), (d), and (h) may be held not fully responsive. See MPEP § 714<.

Replies to requirements to restrict are treated under MPEP § 818.

### 714.03 Amendments Not Fully Responsive, Action To Be Taken [R-3]

37 CFR 1.135. Abandonment for failure to reply within time period.

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(c) When reply by the applicant is a *bona fide* attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

An examiner may treat an amendment not fully responsive to a non-final Office action by:

(A) accepting the amendment as an adequate reply to the non-final Office action to avoid abandonment under 35 U.S.C. 133 and 37 CFR 1.135;

(B) notifying the applicant that the reply must be completed within the remaining period for reply to the non-final Office action (or within any extension pursuant to 37 CFR 1.136(a)) to avoid abandonment; or

(C) setting a new time period for applicant to complete the reply pursuant to 37 CFR 1.135(c).

The treatment to be given to the amendment depends upon:

(A) whether the amendment is *bona fide*;

(B) whether there is sufficient time for applicant's reply to be filed within the time period for reply to the non-final Office action; and

(C) the nature of the deficiency.

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Where an amendment substantially responds to the rejections, objections, or requirements in a non-final Office action (and is a *bona fide* attempt to advance the application to final action) but contains a minor deficiency (e.g., fails to treat every rejection, objection, or requirement), the examiner may simply act on the amendment and issue a new (non-final or final) Office action. The new Office action may simply reiterate the rejection, objection, or requirement not addressed by the amendment (or otherwise indicate that such rejection, objection, or requirement is no longer applicable). This course of action would not be appropriate in instances in which an amendment contains a serious deficiency (e.g., the amendment is unsigned or does not appear to have been filed in reply to the non-final Office action). Where the amendment is *bona fide* but contains a serious omission, the examiner should: A) if there is sufficient time remaining for applicant's reply to be filed within the time period for reply to the non-final Office action (or within any extension pursuant to 37 CFR 1.136(a)), notify applicant that the omission must be supplied within the time period for reply; or B) if there is insufficient time remaining, issue an Office action setting a 1-month time period to complete the reply pursuant to 37 CFR 1.135(c). In either event, the examiner should not further examine the application on its merits unless and until the omission is timely supplied.

If a new time period for reply is set pursuant to 37 CFR 1.135(c), applicant must supply the omission within this new time period for reply (or any extensions under 37 CFR 1.136(a) thereof) in order to avoid abandonment of the application. The applicant, however, may file a continuing application during this period (in addition or as an alternative to supplying the omission), and may also file any further reply as permitted under 37 CFR 1.111.

Where there is sufficient time remaining in the period for reply (including extensions under 37 CFR 1.136(a)), the applicant may simply be notified that

the omission must be supplied within the remaining time period for reply. This notification should be made, if possible, by telephone, and, when such notification is made by telephone, an interview summary record (see MPEP § 713.04) must be completed and entered into the file of the application to provide a record of such notification. When notification by telephone is not possible, the applicant must be notified in an Office communication that the omission must be supplied within the remaining time period for reply. For example, when an amendment is filed shortly after an Office action has been mailed, and it is apparent that the amendment was not filed in reply to such Office action, the examiner need only notify the applicant (preferably by telephone) that a reply responsive to the Office action must be supplied within the remaining time period for reply to such Office action.

The practice set forth in 37 CFR 1.135(c) does not apply where there has been a deliberate omission of some necessary part of a complete reply; rather, 37 CFR 1.135(c) is applicable only when the missing matter or lack of compliance is considered by the examiner as being "inadvertently omitted." For example, if an election of species has been required and applicant does not make an election because he or she believes the requirement to be improper, the amendment on its face is not a "*bona fide* attempt to advance the application to final action" (37 CFR 1.135(c)), and the examiner is without authority to postpone decision as to abandonment. Similarly, an amendment that would cancel all of the claims in an application and does not present any new or substitute claims is not a *bona fide* attempt to advance the application to final action. The Office will not enter such an amendment. See *Exxon Corp. v. Phillips Petroleum Co.*, 265 F.3d 1249, 60 USPQ2d 1368 (Fed. Cir. 2001). If there is time remaining to reply to the non-final Office action (or within any extension of time pursuant to 37 CFR 1.136(a)), applicant will be notified to complete the reply within the remaining time period to avoid abandonment. Likewise, once an inadvertent omission is brought to the attention of the applicant, the question of inadvertence no longer exists. Therefore, a second Office action giving another new (1 month) time period to supply the omission would not be appropriate under 37 CFR 1.135(c).

37 CFR 1.135(c) authorizes, but does not require, an examiner to give the applicant a new time period to supply an omission. Thus, where the examiner concludes that the applicant is attempting to abuse the practice under 37 CFR 1.135(c) to obtain additional time for filing a reply (or where there is sufficient time for applicant's reply to be filed within the time period for reply to the non-final Office action), the examiner need only indicate by telephone or in an Office communication (as discussed above) that the reply must be completed within the period for reply to the non-final Office action or within any extension pursuant to 37 CFR 1.136(a) to avoid abandonment.

The practice under 37 CFR 1.135(c) of giving applicant a time period to supply an omission in a *bona fide* reply does **not** apply after a final Office action. Amendments after final are approved for entry only if they place the application in condition for allowance or in better form for appeal. Otherwise, they are not approved for entry. See MPEP § 714.12 and § 714.13. Thus, an amendment should be denied entry if some point necessary for a complete reply under 37 CFR 1.113 (after final) was omitted, even if the omission was through an apparent oversight or inadvertence. Where a submission after a final Office action \*\* (e.g., an amendment under 37 CFR 1.116) does not place the application in condition for allowance, the period for reply under 37 CFR 1.113 continues to run until a reply under 37 CFR 1.113 (i.e., a notice of appeal or an amendment that places the application in condition for allowance) is filed. The nature of the omission (e.g., whether the amendment raises new issues, or would place the application in condition for allowance but for it being unsigned or not in compliance with 37 CFR 1.121) is immaterial. The examiner cannot give the applicant a time period under 37 CFR 1.135(c) to supply the omission; however, applicant may obtain additional time under 37 CFR 1.136(a) to file another or supplemental amendment in order to supply the omission.

When a reply to a final Office action substantially places the application in condition for allowance, an examiner may request that the applicant (or representative) authorize an examiner's amendment to correct the omission and place the application in condition for allowance, in which case the date of the reply is the date of such authorization (and not the date the

incomplete reply was filed). An examiner also has the authority to enter the reply, withdraw the finality of the last Office action, and issue a new Office action, which may be a non-final Office action, a final Office action (if appropriate), or an action closing prosecution on the merits in an otherwise allowable application under *Ex parte Quayle*, 25 USPQ 74, 1935 C.D. 11, 435 O.G. 213 (Comm'r Pat. 1935) (if appropriate). These courses of action, however, are solely within the discretion of the examiner. It is the applicant's responsibility to take the necessary action in an application under a final Office action to provide a complete reply under 37 CFR 1.113.

Where there is an informality as to the fee in connection with an amendment to a **non-final** Office action presenting additional claims, the applicant is notified by the technical support staff. See MPEP § 607 and § 714.10.

Form paragraph 7.95, and optionally form paragraph 7.95.01, should be used where a *bona fide* reply to a non-final Office action is not fully responsive.

#### ¶ 7.95 *Bona Fide, Non-Responsive Amendments*

The reply filed on [1] is not fully responsive to the prior Office action because of the following omission(s) or matter(s): [2]. See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given a TIME PERIOD of **ONE (1) MONTH** or **THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).**

#### **Examiner Note:**

This practice does not apply where there has been a deliberate omission of some necessary part of a complete reply, or where the application is subject to a final Office action. Under such cases, the examiner has no authority to grant an extension if the period for reply has expired. See form paragraph 7.91.

#### ¶ 7.95.01 *Lack of Arguments in Response*

Applicant should submit an argument under the heading "Remarks" pointing out disagreements with the examiner's contentions. Applicant must also discuss the references applied against the claims, explaining how the claims avoid the references or distinguish from them.

#### **Examiner Note:**

1. This form paragraph must be preceded by form paragraph 7.95.
2. This form paragraph is intended primarily for use in *pro se* applications.

### 714.03(a) >Supplemental< Amendment \*\* [R-3]

37 CFR 1.111. Reply by applicant or patent owner to a non-final Office action.

(a)(1) If the Office action after the first examination (§ 1.104) is adverse in any respect, the applicant or patent owner, if he or she persists in his or her application for a patent or reexamination proceeding, must reply and request reconsideration or further examination, with or without amendment. See §§ 1.135 and 1.136 for time for reply to avoid abandonment.

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(2) *Supplemental replies.* (i) A reply that is supplemental to a reply that is in compliance with § 1.111(b) will not be entered as a matter of right except as provided in paragraph (a)(2)(ii) of this section. The Office may enter a supplemental reply if the supplemental reply is clearly limited to:

- (A) Cancellation of a claim(s);
- (B) Adoption of the examiner suggestion(s);
- (C) Placement of the application in condition for allowance;
- (D) Reply to an Office requirement made after the first reply was filed;
- (E) Correction of informalities (e.g., typographical errors); or
- (F) Simplification of issues for appeal.

(ii) A supplemental reply will be entered if the supplemental reply is filed within the period during which action by the Office is suspended under § 1.103(a) or (c).<

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Applicants are encouraged to include a complete \*>fully responsive reply in compliance with 37 CFR 1.111(b)< to an outstanding Office action in the first reply to prevent the need for supplemental replies. \*\*>Supplemental replies will not be entered as a matter of right, except when a supplemental reply is filed within a suspended period under 37 CFR 1.103(a) or (c) (e.g., a suspension of action requested by the applicant when filing an RCE). See MPEP § 709 regarding suspension of action. The Office may enter a supplemental reply if the supplemental reply is clearly limited to:

- (A) cancellation of a claim;
- (B) adoption of the examiner's suggestions;

(C) placement of the application in condition of allowance;

(D) reply to an Office requirement made after the first reply was filed;

(E) correction of informalities (e.g., typographical errors); or

(F) simplification of issues for appeal.

When a supplemental reply is filed in sufficient time to be entered into the application before the examiner considers the prior reply, the examiner may approve the entry of the supplemental reply if, after a cursory review, the examiner determines that the supplemental reply is limited to one of the situations set forth above. This list is not exhaustive. The examiner has the discretion to approve the entry of a supplemental reply that is not listed above. If a supplemental reply is a non-compliant amendment under 37 CFR 1.121 (see MPEP § 714), the supplemental reply will not be entered. If a supplemental reply is not approved for entry, the examiner should notify the applicant in the subsequent Office action. If applicant wishes to have a not-entered supplemental reply considered, applicant should include the changes in a reply filed in response to the next Office action. Applicant cannot simply request for its entry in the subsequent reply. The submission of a supplemental reply will cause a reduction of any accumulated patent term adjustment under 37 CFR 1.704(c)(8). If the supplemental reply is approved for entry, the examiner should clearly indicate that the subsequent Office action is responsive to the first reply and the supplemental reply.

Examiners may use form paragraph 7.147 to notify applicants that a supplemental reply is not approved for entry.

#### ¶ 7.147 Supplemental Reply Not Approved for Entry

The supplemental reply filed on [1] was not entered because supplemental replies are not entered as a matter of right except as provided in 37 CFR 1.111(a)(2)(ii). [2].

#### Examiner Note:

1. Use this form paragraph to notify applicant that the supplemental reply filed on or after October 21, 2004 is not approved for entry.
2. Do not use this form paragraph if the supplemental reply has been entered. Use the Office Action Summary (PTOL-326) or the Notice of Allowability (PTOL-37), whichever is appropriate, to indicate that the Office action is responsive to the reply filed in compliance with 37 CFR 1.111(b) and the supplemental reply.

3. Do not use this form paragraph if the supplemental reply was filed within the period during which action is suspended by the Office under 37 CFR 1.103(a) or (c). Such supplemental reply must be entered. If the supplemental reply filed during the suspended period is not in compliance with 37 CFR 1.121, a notice of non-compliant amendment (PTOL-324) should be mailed to the applicant.

4. In bracket 1, provide the date that the Office received the supplemental reply (use the date of receipt under 37 CFR 1.6, not the certificate of mailing date under 37 CFR 1.8).

5. In bracket 2, insert a reason for non-entry as noted in 37 CFR 1.111(a)(2)(i). For example, "The supplemental reply is clearly not limited to placement of the application in condition for allowance."

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If a supplemental reply is received in the Office after the mail date of an Office action, and it is not responsive to that Office action, the Office will not mail a new Office action responsive to that supplemental reply. As a courtesy, applicant may be notified that the supplemental reply is nonresponsive to the mailed Office action and that a responsive reply (under 37 CFR 1.111 or 1.113 as the situation may be) to the mailed Office action must be timely filed to avoid abandonment. Also see MPEP § 714.03 for replies not fully responsive and MPEP § 714.05 when the Office action crosses in the mail with a supplemental reply.

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#### **714.04 Claims Presented in Amendment With No Attempt To Point Out Patentable Novelty**

In the consideration of claims in an amended case where no attempt is made to point out the patentable novelty, the claims should *not* be allowed. See 37 CFR 1.111 and MPEP § 714.02.

An amendment failing to point out the patentable novelty which the applicant believes the claims present in view of the state of the art disclosed by the references cited or the objections made may be held to be not fully responsive and a time period set to furnish a proper reply if the statutory period has expired or almost expired (MPEP § 714.03). However, if the claims as amended are clearly open to rejection on grounds of record, a final rejection should generally be made.

#### **714.05 Examiner Should Immediately Inspect [R-3]**

Actions by applicant, especially those filed near the end of the period for reply, should be inspected immediately upon filing to determine whether they are completely responsive to the preceding Office action so as to prevent abandonment of the application. If found inadequate, and sufficient time remains, applicant should be notified of the deficiencies and warned to complete the reply within the period. See MPEP § 714.03.

All amended applications forwarded to the examiner should be inspected at once to determine the following:

(A) If the amendment is properly signed (MPEP § 714.01(a)).

(B) If the amendment has been filed within the statutory period, set shortened period, or time limit (MPEP § 710 - § 710.05).

(C) If the amendment is fully responsive (MPEP § 714.03 and § 714.04) and complies with 37 CFR 1.121 >(MPEP § 714)<.

(D) If the changes made by the amendment warrant transfer (MPEP § 903.08(d)).

(E) If the application is special (MPEP § 708.01).

(F) If claims suggested to applicant for interference purposes have been copied. (MPEP \*>Chapter 2300<).

(G) If there is a traversal of a requirement for restriction (MPEP § 818.03(a)).

(H) If "easily erasable" paper or other nonpermanent method of preparation or reproduction has been used (MPEP § 714.07).

(I) If applicant has cited references (MPEP § 707.05(b) and § 1302.12).

(J) If a terminal disclaimer has been filed (MPEP \* § 804.02, § 804.03, and § 1490).

(K) If any matter involving security has been added (MPEP § 115).

#### **ACTION CROSSES AMENDMENT**

A supplemental action \*\*>may be< necessary when an amendment is filed on or before the mailing date of the regular action but reaches the Technology Center later. The supplemental action should be promptly prepared. It need not reiterate all portions of the previous action that are still applicable but it

should specify which portions are to be disregarded, pointing out that the period for reply runs from the mailing of the supplemental action. The action should be headed "Responsive to amendment of (date) and supplemental to the action mailed (date)."

#### **714.06 Amendments Sent to Wrong Technology Center**

See MPEP § 508.01.

#### **714.07 Amendments Not in Permanent Ink [R-3]**

37 CFR 1.52(a) requires "permanent dark ink or its equivalent" to be used on papers which will become part of the record and *In re Benson*, 122 USPQ 279, 1959 C.D. 5, 744 O.G. 353 (Comm'r Pat. 1959), holds that documents on so-called "easily erasable" paper violate the requirement. The fact that 37 CFR 1.52(a) has not been complied with may be discovered as soon as the amendment reaches the TC or later when the application is reached for action. In the first instance, applicant is promptly notified that the amendment is not entered and is required to file a permanent copy within 1 month or to order a copy to be made by the U.S. Patent and Trademark Office at his or her expense. Physical entry of the amendment will be made from the permanent copy.

If there is no appropriate reply within the 1-month limit, a copy is made by the Patent and Trademark Office, applicant being notified and required to remit the charges or authorize charging them to his or her deposit account or credit card. See MPEP § 509.

In the second instance, when the nonpermanence of the amendment is discovered only when the application is reached for action, similar steps are taken, but action on the application is not held up, the requirement for a permanent copy of the amendment being included in the Office action.

A good direct or indirect copy, such as photocopy or facsimile transmission, on satisfactory paper is acceptable. But see *In re Application Papers Filed Jan. 20, 1956*, 706 O.G. 4 (Comm'r Pat. 1956). \*\*

See MPEP § 608.01 for more discussion on acceptable copies.

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#### **714.10 Claims Added in Excess of \*\*>Claims Previously Paid For< [R-3]**

\*\*>Applicant is required to pay excess claims fees for each claim that is in excess of 3 in independent form or in excess of 20 (whether dependent or independent). Fees for a proper multiple dependent claim are calculated based on the number of claims to which the multiple dependent claim refers (37 CFR 1.75(c)) and a separate fee is also required in each application containing a proper multiple dependent claim. See MPEP § 607. When applicant adds a new excess claim that is in excess of the number of claims that were previously paid for after taking into account claims that have been canceled, applicant must pay the required excess claims fees before the examiner considers the new claim. For example, in an application that contains 6 independent claims and 30 total claims for which the excess claims fees were previously paid, when applicant cancels 10 claims, 2 of which are independent, and adds 11 claims, 3 of which are independent, excess claims fees for a 7<sup>th</sup> independent claim and a 31<sup>st</sup> claim are required.<

#### **714.11 Amendment Filed During Interference Proceedings [R-3]**

See MPEP \*>Chapter 2300<.

#### **714.12 Amendments >and Other Replies< After Final Rejection or Action [R-3]**

\*\*>

37 CFR 1.116. *Amendments and affidavits or other evidence after final action and prior to appeal.*

(a) An amendment after final action must comply with § 1.114 or this section.

(b) After a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913, but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):

(1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;



(2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or

(3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

(c) The admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings will not operate to relieve the application or reexamination proceeding from its condition as subject to appeal or to save the application from abandonment under § 1.135, or the reexamination prosecution from termination under § 1.550(d) or § 1.957(b) or limitation of further prosecution under § 1.957(c).

(d)(1) Notwithstanding the provisions of paragraph (b) of this section, no amendment other than canceling claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, can be made in an inter partes reexamination proceeding after the right of appeal notice under § 1.953 except as provided in § 1.981 or as permitted by § 41.77(b)(1) of this title.

(2) Notwithstanding the provisions of paragraph (b) of this section, an amendment made after a final rejection or other final action (§ 1.113) in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913 may not cancel claims where such cancellation affects the scope of any other pending claim in the reexamination proceeding except as provided in § 1.981 or as permitted by § 41.77(b)(1) of this title.

(e) An affidavit or other evidence submitted after a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913 but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title), may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented.

(f) Notwithstanding the provisions of paragraph (e) of this section, no affidavit or other evidence can be made in an inter partes reexamination proceeding after the right of appeal notice under § 1.953 except as provided in § 1.981 or as permitted by § 41.77(b)(1) of this title.

(g) After decision on appeal, amendments, affidavits and other evidence can only be made as provided in §§ 1.198 and 1.981, or to carry into effect a recommendation under § 41.50(c) of this title.<

Once a final rejection that is not premature has been entered in an application, applicant or patent owner no longer has any right to unrestricted further prosecution. This does not mean that no further amendment or argument will be considered. Any amendment that will place the application either in condition for allowance or in better form for appeal may be entered. Also, amendments >filed after a final rejection, but before or on the date of filing an appeal,< complying

with objections or requirements as to form are to be permitted after final action in accordance with 37 CFR 1.116(b). >Amendments filed after the date of filing an appeal may be entered if the amendment complies with 37 CFR 41.33. See MPEP § 1206.< Ordinarily, amendments filed after the final action are not entered unless approved by the examiner. See MPEP § 706.07(f), § 714.13 and § \*>1206<.

>An affidavit or other evidence filed after a final rejection, but before or on the same date of filing an appeal, may be entered upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented in compliance with 37 CFR 1.116(e). See 37 CFR 41.33 and MPEP § 1206 for information on affidavit or other evidence filed after appeal.<

*The prosecution of an application before the examiner should ordinarily be concluded~with~the final action. However, one personal interview by applicant may be entertained after such final action if circumstances warrant.* Thus, only one request by applicant for a personal interview after final should be granted, but in exceptional circumstances, a second personal interview may be initiated by the *examiner* if in his or her judgment this would materially assist in placing the application in condition for *allowance*.

Many of the difficulties encountered in the prosecution of patent applications after final rejection may be alleviated if each applicant includes, at the time of filing or no later than the first reply, claims varying from the broadest to which he or she believes he or she is entitled to the most detailed that he or she is willing to accept.

## **714.13 Amendments and Other Replies After Final Rejection or Action, Procedure Followed [R-5]**

### **I. FINAL REJECTION — TIME FOR REPLY**

If an applicant initially replies within 2 months from the date of mailing of any final rejection setting a 3-month shortened statutory period for reply and the Office does not mail an advisory action until after the end of the 3-month shortened statutory period, the period for reply for purposes of determining the amount of any extension fee will be the date on which the Office mails the advisory action advising applicant of the status of the application, but in no event



can the period extend beyond 6 months from the date of the final rejection. This procedure applies only to a first reply to a final rejection. The following language must be included by the examiner in each final rejection:

A SHORTENED STATUTORY PERIOD FOR REPLY TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST REPLY IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CFR 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR REPLY EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

This wording is part of form paragraphs 7.39, 7.40, 7.40.01, >7.40.02,< 7.41, 7.41.03, >7.42.03,< and 7.42.09. Form paragraph 7.39 appears in MPEP § 706.07. Form paragraphs 7.40 and 7.40.01 appear in MPEP § 706.07(a). Form paragraphs >7.40.02,< 7.41, 7.41.03, and 7.42.09 appear in MPEP § 706.07(b). >Form paragraph 7.42.03 appears in MPEP § 706.07(g).<

For example, if applicant initially replies within 2 months from the date of mailing of a final rejection and the examiner mails an advisory action before the end of 3 months from the date of mailing of the final rejection, the shortened statutory period will expire at the end of 3 months from the date of mailing of the final rejection. In such a case, any extension fee would then be calculated from the end of the 3-month period. If the examiner, however, does not mail an advisory action until after the end of 3 months, the shortened statutory period will expire on the date the examiner mails the advisory action and any extension fee may be calculated from that date. In the event that a first reply is not filed within 2 months of the mailing date of the final rejection, any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the end of the reply period set in the final rejection.

Failure to file a reply during the shortened statutory period results in abandonment of the application unless the time is extended under the provisions of 37 CFR 1.136.

## II. ENTRY NOT A MATTER OF RIGHT

It should be kept in mind that applicant cannot, as a matter of right, amend any finally rejected claims, add new claims after a final rejection (see 37 CFR 1.116) or reinstate previously canceled claims.

Except where an amendment merely cancels claims, adopts examiner suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner, compliance with the requirement of a showing under 37 CFR 1.116(b)(3) is expected in all amendments after final rejection. An affidavit or other evidence filed after a final rejection, but before or on the same date of filing an appeal, may be entered upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented in compliance with 37 CFR 1.116(e). See 37 CFR 41.33 and MPEP § 1206 for information on affidavit or other evidence filed after appeal. Failure to properly reply under 37 CFR 1.113 to the final rejection results in abandonment. A reply under 37 CFR 1.113 is limited to:

(A) an amendment complying with 37 CFR 1.116;

(B) a Notice of Appeal (and appeal fee); or

(C) a request for continued examination (RCE) filed under 37 CFR 1.114 with a submission (i.e., an amendment that meets the reply requirement of 37 CFR 1.111) and the fee set forth in 37 CFR 1.17(e). RCE practice under 37 CFR 1.114 does not apply to utility or plant patent applications filed before June 8, 1995 and design applications.

Further examination of the application may be obtained by filing a continued prosecution application (CPA) under 37 CFR 1.53(d), if the application is a design application. See MPEP § 201.06(d). Effective July 14, 2003, CPA practice does not apply to utility and plant applications.

An amendment filed at any time after final rejection, but before an appeal brief is filed, may be entered upon or after filing of an appeal brief provided the total effect of the amendment is to (A)

remove issues for appeal, and/or (B) adopt examiner suggestions.

See also MPEP § 1206 and § 1211.

The U.S. Patent and Trademark Office does not recognize “conditional” authorizations to charge an appeal fee if an amendment submitted after a final Office action is not entered. Any “conditional” authorization to charge an appeal fee set forth in 37 CFR 1.17(b) will be treated as an unconditional payment of the fee set forth in 37 CFR 1.17(b).

### III. ACTION BY EXAMINER

See also MPEP § 706.07(f).

In the event that a proposed amendment does not place the case in better form for appeal, nor in condition for allowance, applicant should be promptly informed of this fact, whenever possible, within the statutory period. The refusal to enter the proposed amendment should not be arbitrary. The proposed amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified. Ordinarily, the specific deficiencies of the amendment need not be discussed. However, if the proposed amendment raises the issue of new matter, the examiner should identify the subject matter that would constitute new matter. If the proposed amendment presents new issues requiring further consideration and/or search, the examiner should provide an explanation as to the reasons why the proposed amendment raises new issues that would require further consideration and/or search. The reasons for non-entry should be concisely expressed. For example:

(A) The claims, if amended as proposed, would not avoid any of the rejections set forth in the last Office action, and thus the amendment would not place the case in condition for allowance or in better condition for appeal.

(B) The claims, if amended as proposed, would raise the issue of new matter.

(C) The claims as amended present new issues requiring further consideration or search.

(D) Since the amendment presents additional claims without canceling any finally rejected claims it is not considered as placing the application in better condition for appeal. *Ex parte Wirt*, 1905 C.D. 247, 117 O.G. 599 (Comm’r Pat. 1905).

Examiners should indicate the status of each claim of record or proposed in the amendment, and which proposed claims would be entered on the filing of an appeal if filed in a separate paper. Whenever such an amendment is entered for appeal purposes, the examiner must indicate on the advisory action which individual rejection(s) set forth in the action from which the appeal was taken (e.g., the final rejection) would be used to reject the new or amended claim(s).

Applicant should be notified, if certain portions of the amendment would be acceptable as placing some of the claims in better form for appeal or complying with objections or requirements as to form, if a separate paper were filed containing only such amendments. Similarly, if the proposed amendment to some of the claims would render them allowable, applicant should be so informed. This is helpful in assuring the filing of a brief consistent with the claims as amended. A statement that the final rejection stands and that the statutory period runs from the date of the final rejection is also in order.

Advisory Action Before the Filing of an Appeal Brief form PTOL-303 should be used to acknowledge receipt of a reply from applicant after final rejection where such reply is prior to filing of an appeal brief and does not place the application in condition for allowance. This form has been devised to advise applicant of the disposition of the proposed amendments to the claims and of the effect of any argument or affidavit not placing the application in condition for allowance or which could not be made allowable by a telephone call to clear up minor matters.

Any amendment timely filed after a final rejection should be immediately considered to determine whether it places the application in condition for allowance or in better form for appeal. An examiner is expected to turn in a response to an amendment after final rejection within 10 calendar days from the time the amendment is received by the examiner. A reply to an amendment after final rejection should be mailed within 30 days of the date the amendment is received by the Office. In *all* instances, both before and after final rejection, in which an application is placed in condition for allowance, applicant should be notified promptly of the allowability of the claims by a Notice of Allowability form PTOL-37. If delays in processing the Notice of Allowability are expected, e.g., because an extensive examiner’s amendment

must be entered, and the end of a statutory period for reply is near, the examiner should notify applicant by way of an interview that the application has been placed in condition for allowance, and an Examiner Initiated Interview Summary PTOL-413B should be mailed. Prompt notice to applicant is important because it may avoid an unnecessary appeal and act as a safeguard against a holding of abandonment. Every effort should be made to mail the letter before the period for reply expires.

If no appeal has been filed within the period for reply and no amendment has been submitted to make the application allowable or which can be entered in part (see MPEP § 714.20), the application stands abandoned.

It should be noted that under 37 CFR 1.181(f), the filing of a 37 CFR 1.181 petition will not stay the period for reply to an examiner's action which may be running against an application. See MPEP § 1206 for appeal and post-appeal procedure. For after final rejection practice relative to affidavits or declarations filed under 37 CFR 1.131 and 1.132, see MPEP § 715.09 and § 716.

Form paragraph 7.169 may be used to notify applicant in the Advisory Action that the proposed amendment(s) will be entered upon appeal and how the new or amended claim(s) would be rejected.

**¶ 7.169 Advisory Action, Proposed Rejection of Claims, Before Appeal Brief**

For purposes of appeal, the proposed amendment(s) will be entered and the proposed rejection(s) detailed below will be included in the Examiner's Answer. To be complete, such rejection(s) must be addressed in any brief on appeal.

Upon entry of the amendment(s) for purposes of appeal:

Claim(s) [1] would be rejected for the reasons set forth in [2] of the final Office action mailed [3].

**Examiner Note:**

1. In bracket 1, identify all the new or amended claim(s) that would be grouped together in a single rejection.
2. In bracket 2, identify the rejection by referring to either the paragraph number or the statement of the rejection (e.g., the rejection under 35 U.S.C. § 103 based upon A in view of B) in the final Office action under which the claims would be rejected on appeal.
3. Repeat this form paragraph for each group of claims subject to the same rejection(s).
4. Use this form paragraph if item 7 of the Advisory Action form, PTOL-303 (Rev. 9-04 or later) has been checked to indicate that the proposed amendment(s) will be entered upon appeal.

#### IV. HAND DELIVERY OF PAPERS

Hand carried papers for the Technology Centers (TCs) may only be delivered to the Customer Window which is located at:

U.S. Patent and Trademark Office  
Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Effective December 1, 2003, all official patent application related correspondence for organizations reporting to the Commissioner of Patents (e.g., TCs, the Office of Patent Publication, and the Office of Petitions) that is hand-carried (or delivered by other delivery services, e.g., FedEx, UPS, etc.) must be delivered to the Customer Window, with a few limited exceptions. See MPEP § 502. Hand-carried amendments and other replies after final rejection (37 CFR 1.116) will no longer be accepted in the TCs. Any courier who attempts delivery of such after final correspondence at a TC (or where it is no longer permitted) will be re-directed to the Customer Window. Patent application related compact disks (CDs) and other non-paper submissions that are hand-carried must be delivered to the Customer Window.

#### V. EXPEDITED PROCEDURE FOR PROCESSING AMENDMENTS AND OTHER REPLIES AFTER FINAL REJECTION (37 CFR 1.116)

In an effort to improve the timeliness of the processing of amendments and other replies under 37 CFR 1.116, and thereby provide better service to the public, an expedited processing procedure has been established which the public may utilize in filing amendments and other replies after final rejection under 37 CFR 1.116. In order for an applicant to take advantage of the expedited procedure, the amendment or other reply under 37 CFR 1.116 will have to be marked as a "Reply under 37 CFR 1.116 — Expedited Procedure - Technology Center (Insert Technology Center Number)" on the upper right portion of the amendment or other reply and the envelope must be marked "Mail Stop AF" in the lower left hand corner. The markings preferably should be written in a bright color with a felt point marker. If the reply is mailed to

the Office, the envelope should contain only replies under 37 CFR 1.116 and should be mailed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia, 22313-1450." Instead of mailing the envelope to "Mail Stop AF" as noted above, the reply may be hand-carried to the Customer Window located at the above address. The outside of the envelope should be marked "Reply Under 37 CFR 1.116 - Expedited Procedure - Technology Center (Insert Technology Center Number)."

Upon receipt by the U.S. Patent and Trademark Office from the U.S. Postal Service of an envelope appropriately marked "Mail Stop AF," the envelope will be specially processed by the Mail Center and for non-Image File Wrapper applications (non-IFW) forwarded promptly to the examining TC, via the Office of Finance if any fees have to be charged or otherwise processed. For IFW application processing, see IFW Manual. Upon receipt of the reply in the TC it will be promptly processed by a designated technical support staff member and forwarded to the examiner, via the supervisory patent examiner (SPE), for action. The SPE is responsible for ensuring that prompt action on the reply is taken by the examiner. If the examiner to which the application is assigned is not available and will not be available for an extended period, the SPE will ensure that action on the application is promptly taken to assure meeting the USPTO goal described below. Once the examiner has completed his or her consideration of the reply, the examiner's action will be promptly typed and printed, and mailed by technical support staff or other Office personnel designated to expedite the processing of replies filed under this procedure. The TC supervisory personnel, e.g., the supervisory patent examiner, supervisory applications examiner, and TC Director are responsible for ensuring that actions on replies filed under this procedure are promptly processed and mailed. The U.S. Patent and Trademark Office goal is to mail the examiner's action on the reply within 1 month from the date on which the amendment or reply is received by the U.S. Patent and Trademark Office.

Applicants are encouraged to utilize this expedited procedure in order to facilitate U.S. Patent and Trademark Office processing of replies under 37 CFR 1.116. If applicants do not utilize the procedure by appropriately marking the envelope and enclosed papers, the benefits expected to be achieved therefrom

will not be attained. The procedure cannot be expected to result in achievement of the goal in applications in which the delay results from actions by the applicant, e.g., delayed interviews, applicant's desire to file a further reply, or a petition by applicant which requires a decision and delays action on the reply. In any application in which a reply under this procedure has been filed and no action by the examiner has been received within the time referred to herein, plus normal mailing time, a telephone call to the SPE of the relevant TC art unit would be appropriate in order to permit the SPE to determine the cause for any delay. If the SPE is unavailable or if no satisfactory reply is received, the TC Director should be contacted.

### 714.14 Amendments After Allowance of All Claims [R-3]

Under the decision in *Ex parte Quayle*, 25 USPQ 74, 1935 C.D. 11; 453 O.G. 213 (Comm'r Pat. 1935), after all claims in an application have been allowed the prosecution of the application on the merits is closed even though there may be outstanding formal objections which preclude fully closing the prosecution.

Amendments touching the merits are treated in a manner similar to amendments after final rejection, though the prosecution may be continued as to the formal matters. See MPEP § 714.12 and § 714.13.

See MPEP § 714.20 for amendments entered in part.

See MPEP § 607 for additional fee requirements.

See MPEP § 714 for non-compliant amendments.

Use form paragraph 7.51 to issue an *Ex parte Quayle* action.

\*\*>

#### ¶ 7.51 *Quayle* Action

This application is in condition for allowance except for the following formal matters: [1].

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935).

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

#### Examiner Note:

Explain the formal matters which must be corrected in bracket 1.

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### 714.15 Amendment Received in Technology Center After Mailing of Notice of Allowance [R-3]

Where an amendment, even though prepared by applicant prior to allowance, does not reach the Office until after the notice of allowance has been mailed, such amendment has the status of one filed under 37 CFR 1.312. Its entry is a matter of grace. For discussion of amendments filed under 37 CFR 1.312, see MPEP § 714.16 to § 714.16(e).

If \* the amendment is filed in the Office prior to the mailing \* of the notice of allowance, but is received by the examiner after the mailing of the notice of allowance, it \*\*>may also not be approved for entry. If the amendment is a supplemental reply filed when action is not suspended, such an amendment will not be approved for entry because supplemental replies are not entered as matter of right. See 37 CFR 1.111(a)(2) and MPEP § 714.03(a). If the amendment is a preliminary amendment, such an amendment may be disapproved under 37 CFR 1.115(b). See MPEP § 714.01(e). If the amendment is approved for entry, the examiner may enter the amendment and provide a supplemental notice of allowance, or withdraw the application from issue and provide an Office action.<

\*\*>The< application will not be withdrawn from issue for the entry of an amendment that would reopen the prosecution if the Office action next preceding the notice of allowance closed the application to further amendment, i.e., by indicating the patentability of all of the claims, or by allowing some and finally rejecting the remainder.

After an applicant has been notified that the claims are all allowable, further prosecution of the merits of the application is a matter of grace and not of right. *Ex parte Quayle*, 25 USPQ 74, 1935 C.D. 11, 453 O.G. 213 (Comm'r Pat. 1935).

### 714.16 Amendment After Notice of Allowance, 37 CFR 1.312 [R-3]

#### 37 CFR 1.312. Amendments after allowance.

No amendment may be made as a matter of right in an application after the mailing of the notice of allowance. Any amendment filed pursuant to this section must be filed before or with the payment of the issue fee, and may be entered on the recommendation of the primary examiner, approved by the Director, without withdrawing the application from issue.

The amendment of an application by applicant after allowance falls within the guidelines of 37 CFR 1.312. Further, the amendment of an application broadly encompasses any change in the file record of the application. Accordingly, the following are examples of "amendments" by applicant after allowance which must comply with 37 CFR 1.312:

- (A) an amendment to the specification,
- (B) a change in the drawings,
- (C) an amendment to the claims,
- (D) a change in the inventorship,
- (E) the submission of prior art,

>

(F) a petition to correct the spelling of an inventor's name,

(G) a petition to change the order of the names of the inventors,< etc.

Finally, it is pointed out that an amendment under 37 CFR 1.312 must be filed on or before the date the issue fee is paid, except where the amendment is required by the Office of Patent Publication, see MPEP § 714.16(d), subsection III. An amendment under 37 CFR 1.312 must comply with the provisions of 37 CFR 1.121. >If the amendment is non-compliant under 37 CFR 1.121 and the entry of the amendment would have been otherwise recommended, the examiner may enter the amendment and correct the non-compliance (e.g., an incorrect status identifier) using an examiner's amendment. See MPEP § 714.<

The Director has delegated the approval of recommendations under 37 CFR 1.312 to the supervisory patent examiners.

With the exception of a supplemental oath or declaration submitted in a reissue, a supplemental oath or declaration is not treated as an amendment under 37 CFR 1.312. See MPEP § 603.01. A supplemental reissue oath or declaration is treated as an amendment under 37 CFR 1.312 because the correction of the patent which it provides is an amendment of the patent, even though no amendment is physically entered into the specification or claim(s). Thus, for a reissue oath or declaration submitted after allowance to be entered, the reissue applicant must comply with 37 CFR 1.312 in the manner set forth in this section.

After the Notice of Allowance has been mailed, the application is technically no longer under the jurisdiction of the primary examiner. He or she can, however,

make examiner's amendments (see MPEP § 1302.04) and has authority to enter amendments submitted after Notice of Allowance of an application which embody merely the correction of formal matters in the specification or drawing, or formal matters in a claim without changing the scope thereof, or the cancellation of claims from the application, without forwarding to the supervisory patent examiner for approval.

Amendments other than those which merely embody the correction of formal matters without changing the scope of the claims require approval by the supervisory patent examiner. The Technology Center (TC) Director establishes TC policy with respect to the treatment of amendments directed to trivial informalities which seldom affect significantly the vital formal requirements of any patent, namely, (A) that its disclosure be adequately clear, and (B) that any invention present be defined with sufficient clarity to form an adequate basis for an enforceable contract.

Consideration of an amendment under 37 CFR 1.312 cannot be demanded as a matter of right. Prosecution of an application should be conducted before, and thus be complete *including editorial revision of the specification and claims* at the time of the Notice of Allowance. However, where amendments of the type noted are shown (A) to be needed for proper disclosure or protection of the invention, and (B) to require no substantial amount of additional work on the part of the Office, they may be considered and, if proper, entry may be recommended by the primary examiner.

The requirements of 37 CFR 1.111(c) (MPEP § 714.02) with respect to pointing out the patentable novelty of any claim sought to be added or amended, apply in the case of an amendment under 37 CFR 1.312, as in ordinary amendments. See MPEP § 713.04 and § 713.10 regarding interviews. As to amendments affecting the disclosure, the scope of any claim, or that add a claim, the remarks accompanying the amendment must fully and clearly state the reasons on which reliance is placed to show:

- (A) why the amendment is needed;
- (B) why the proposed amended or new claims require no additional search or examination;
- (C) why the claims are patentable; and
- (D) why they were not presented earlier.

## I. NOT TO BE USED FOR CONTINUED PROSECUTION

37 CFR 1.312 was never intended to provide a way for the continued prosecution of an application after it has been passed for issue. When the recommendation is against entry, a detailed statement of reasons is not necessary in support of such recommendation. The simple statement that the proposed claim is not obviously allowable and briefly the reason why is usually adequate. Where appropriate, any one of the following reasons is considered sufficient:

- (A) an additional search is required;
- (B) more than a cursory review of the record is necessary; or
- (C) the amendment would involve materially added work on the part of the Office, e.g., checking excessive editorial changes in the specification or claims.

Where claims added by amendment under 37 CFR 1.312 are all of the form of dependent claims, some of the usual reasons for nonentry are less likely to apply although questions of new matter, sufficiency of disclosure, or undue multiplicity of claims could arise.

See MPEP § 607 and § 714.16(c) for additional fee requirements.

## II. AMENDMENTS FILED AFTER PAYMENT OF ISSUE FEE

No amendments should be filed after the date the issue fee has been paid.

### ¶ 13.10 Amendment Filed After the Payment of Issue Fee, Not Entered

Applicant's amendment filed on [1] will not be entered because the amendment was filed after the issue fee was paid. 37 CFR 1.312 no longer permits filing an amendment after the date the issue fee has been paid.

#### Examiner Note:

1. Use this paragraph with form PTOL-90 or PTO-90C.
2. In bracket 1, insert the date of the amendment.

## 714.16(a) Amendments Under 37 CFR 1.312, Copied Patent Claims [R-3]

See MPEP \*Chapter 2300< for the procedure to be followed when an amendment is received after

notice of allowance which includes one or more claims copied or substantially copied from a patent.

The entry of the copied patent claims is not a matter of right. See MPEP § 714.19.

See MPEP § 607 and § 714.16(c) for additional fee requirements.

### **714.16(b) Amendments Under 37 CFR 1.312 Filed With a Motion Under 37 CFR \*41.208< [R-3]**

Where an amendment filed with a motion under 37 CFR \*41.208(c)(2)< applies to an application in issue, the amendment is not entered unless and until the motion has been granted.

### **714.16(c) Amendments Under 37 CFR 1.312, Additional Claims**

If the amendment under 37 CFR 1.312 adds claims (total and independent) in excess of the number previously paid for, additional fees are required. The amendment is *not* considered by the examiner unless accompanied by the full fee required. See MPEP § 607 and 35 U.S.C. 41.

### **714.16(d) Amendments Under 37 CFR 1.312, Handling [R-3]**

#### **I. AMENDMENTS AFFECTING THE DISCLOSURE OF THE SPECIFICATION, ADDING CLAIMS, OR CHANGING THE SCOPE OF ANY CLAIM**

Amendments under 37 CFR 1.312 are sent by the Office of Initial Patent Examination (OIPE) to the Publishing Division which, in turn, forwards, for non-Image File Wrapper applications (non-IFW), the proposed amendment, file, and drawing (if any) to the Technology Center (TC) which allowed the application. For IFW applications, amendments under 37 CFR 1.312 must be sent to the Office of Initial Patent Examination (OIPE) Central Scanning. OIPE Central Scanning will scan the amendments. Upon upload of the images, OIPE Central Scanning will message the Office of Patent Publication (PUBS). PUBS will review the messages and forward the messages to the Technology Center (TC), which allowed the application. Once the TC completes the action, the TC will message PUBS that issue processing can resume. If an

amendment under 37 CFR 1.312 has been filed directly with the TC, the paper will be forwarded to the OIPE Central Scanning.

Hand delivered amendments under 37 CFR 1.312 are no longer accepted in the TC. Hand delivered amendments (unless specifically required by PUBS, see subsection III. below) may only be delivered to the Customer Window located at:

U.S. Patent and Trademark Office  
 \*\*>Customer Service Window  
 Randolph Building  
 401 Dulany Street  
 Alexandria, VA 22314<

In the event that the class and subclass in which the application is classified has been transferred to another TC after the application was allowed, the proposed amendment, file and drawing (if any) are transmitted directly to said other TC and the Publishing Division notified. If the examiner who allowed the application is still employed in the U.S. Patent and Trademark Office but not in said other TC, he or she may be consulted about the propriety of the proposed amendment and given credit for any time spent in giving it consideration.

The amendment is PROMPTLY considered by the examiner who indicates whether or not its entry is recommended by writing "Enter — 312," "Do Not Enter" or "Enter In Part" thereon in red ink in the upper left corner. For IFW processing, \*\*>the examiner should print the first page of the amendment and write either "Enter – 312" or "Do Not Enter" in the upper left corner, and have the page scanned into IFW with the appropriate document code.<

In addition, the amendment must comply with the provisions of 37 CFR 1.121. >See MPEP § 714.<

If the amendment is favorably considered, it is entered and a Response to Rule 312 Communication (PTO-271) is prepared. The primary examiner indicates his or her recommendation by stamping and signing his or her name on the PTO-271. Form paragraph 7.85 may also be used to indicate entry.

#### **¶ 7.85 Amendment Under 37 CFR 1.312 Entered**

The amendment filed on [1] under 37 CFR 1.312 has been entered.

#### **Examiner Note:**

Use this form paragraph both for amendments under 37 CFR 1.312 that do not affect the scope of the claims (may be signed by



primary examiner) and for amendments being entered under 37 CFR 1.312 which do affect the scope of the claims (requires signature of supervisory patent examiner). See MPEP § 714.16.

If the examiner's recommendation is completely adverse, a report giving the reasons for nonentry is typed on the Response to Rule 312 Communication form PTO-271 and signed by the primary examiner.

Form paragraph 7.87 may also be used to indicate nonentry.

**¶ 7.87 Amendment Under 37 CFR 1.312 Not Entered**

The proposed amendment filed on [1] under 37 CFR 1.312 has not been entered. [2]

**Examiner Note:**

The reasons for non-entry should be specified in bracket 2:

- The amendment changes the scope of the claims.--; or
- The amendment was filed in a reissue application and was not accompanied by a supplemental reissue oath or declaration, 37 CFR 1.175(b). --

In either case, whether the amendment is entered or not entered, the file, drawing, and unmailed notices are forwarded to the supervisory patent examiner for consideration, approval, and mailing.

For entry-in-part, see MPEP § 714.16(e).

The filling out of the appropriate form by the technical support staff does not signify that the amendment has been admitted; for, though actually entered it is not officially admitted unless and until approved by the supervisory patent examiner.

See MPEP § 607 and § 714.16(c) for additional fee requirements.

**II. AMENDMENTS WHICH EMBODY MERELY THE CORRECTION OF FORMAL MATTERS IN THE SPECIFICATION, FORMAL CHANGES IN A CLAIM WITHOUT CHANGING THE SCOPE THEREOF, OR THE CANCELLATION OF CLAIMS**

The examiner indicates approval of amendments concerning merely formal matters by writing "Enter Formal Matters Only" thereon. Such amendments do not require submission to the supervisory patent examiner prior to entry. See MPEP § 714.16. The Response to Rule 312 Communication form PTO-271 is date stamped and mailed by the TC. If such amendments are disapproved either in whole or in part, they require the signature of the supervisory patent examiner. \*\*>IFW processing is substantially the same,

with the first page of the amendment being printed, the examiner writing "Enter" and the page being scanned into IFW with the appropriate document code.<

**III. AMENDMENTS REQUIRED BY THE OFFICE OF PATENT PUBLICATION**

In preparation of a patent for issuance as a patent grant, if the Office of Patent Publication (PUBS) discovers an error in the text, or drawings of a patent application, including any missing text, or an inconsistency between the drawings and the application papers, PUBS may require an appropriate amendment to the specification or drawings. 37 CFR 1.312, however, does not permit an amendment after the payment of the issue fee without withdrawal of the application from issue. In order to be able to accept such an amendment as may be required without having to withdraw an application from issue, effective February 24, 2004, PUBS has been delegated the authority to waive the requirement of 37 CFR 1.312 and accept an amendment filed after the payment of the issue fee. Furthermore, these amendments required by PUBS may be hand delivered to PUBS located at:

Office of Patent Publication

\*\*>South Tower Building

2900 Crystal Drive, Room 8A24<

Arlington, VA 22202

Applicants may also fax these amendments required by PUBS to (703) 746-4000.

**714.16(e) Amendments Under 37 CFR 1.312, Entry in Part [R-3]**

The general rule that an amendment cannot be entered in part and refused in part should not be relaxed, but when, under 37 CFR 1.312, an amendment, for example, is proposed containing a plurality of claims or amendments to claims, some of which may be entered and some not, the acceptable claims or amendments should be entered in the application >if the application is a paper file<. If necessary, the claims should be renumbered to run consecutively with the claims already in the case. The refused claims or amendments should be canceled in lead pencil on the amendment. For Image File Wrapper (IFW) processing, see IFW Manual.



The examiner should then submit a Response to Rule 312 Communication form PTO-271 recommending the entry of the acceptable portion of the amendment and the nonentry of the remaining portion together with his or her reasons therefor. The claims entered should be indicated by number in this response. Applicant may also be notified by using form paragraph 7.86.

¶ **7.86 Amendment Under 37 CFR 1.312 Entered in Part**

The amendment filed on [1] under 37 CFR 1.312 has been entered-in-part. [2]

**Examiner Note:**

When an amendment under 37 CFR 1.312 is proposed containing plural changes, some of which may be acceptable and some not, the acceptable changes should be entered. An indication of which changes have and have not been entered with appropriate explanation should follow in bracket 2.

Handling is similar to complete entry of a 37 CFR 1.312 amendment.

Entry in part is not recommended unless the full additional fee required, if any, accompanies the amendment. See MPEP § 607 and § 714.16(c).

**714.17 Amendment Filed After the Period for Reply Has Expired [R-3]**

When an application is not prosecuted within the period set for reply and thereafter an amendment is filed without a petition for extension of time and fee pursuant to 37 CFR 1.136(a), such amendment shall be \*\*>placed in< the file \* of the application, but not formally entered. The technical support staff shall immediately notify the applicant, by telephone and letter, that the amendment was not filed within the time period and therefore cannot be entered and that the application is abandoned unless a petition for extension of time and the appropriate fee are timely filed. See MPEP § 711.02. \*\*

See MPEP § 710.02(e) for a discussion of the requirements of 37 CFR 1.136(a).

**714.18 Entry of Amendments [R-3]**

Amendments >in paper files< are stamped with the date of their receipt in the Technology Center (TC). It

is important to observe the distinction which exists between the stamp which shows the date of receipt of the amendment in the TC ("Technology Center Date" stamp) and the stamp bearing the date of receipt of the amendment by the Office ("Office Date" stamp). The latter date, placed in the left-hand corner, should always be referred to in writing to the applicant with regard to his or her amendment. \*\*

All amendments received in the technical support staff sections are processed and with the applications delivered to the supervisory patent examiner for his or her review and distribution to the examiners.

Every mail delivery should be carefully screened to remove all amendments replying to a final action in which a time period is running against the applicant. Such amendments should be processed within the next 24 hours.

The purpose of this procedure is to ensure uniform and prompt treatment by the examiners of all applications where the applicant is awaiting a reply to a proposed amendment after final action. By having all of these applications pass over the supervisory patent examiner's desk, he or she will be made aware of the need for any special treatment, if the situation so warrants. For example, the supervisory patent examiner will know whether or not the examiner in each application is on extended leave or otherwise incapable of moving the application within the required time periods (see MPEP § 714.13). In cases of this type, the applicant should receive an Office communication in sufficient time to adequately consider his or her next action if the application is not allowed. Consequently, technical support staff handling will continue to be special when these applications are returned by the examiners to the technical support staff.

Evaluation of the amendment after final rejection for compliance with 37 CFR 1.121 should be left to the examiner, and not treated by the technical support staff before forwarding the amendment to the examiner. If the examiner determines that the proposed amendment is not in compliance with 37 CFR 1.121, the examiner should notify applicant of this fact and attach a Notice of Non-Compliant Amendment to the advisory action. >See MPEP § 714.<

The amendment or letter is placed in the file, given its number as a paper in the application, and its character endorsed on the file wrapper in red ink. For IFW processing, \*\*>amendments are entered as papers into the IFW.<

When several amendments are made in an application on the same day no particular order as to the hour of the receipt or the mailing of the amendments can be assumed, but consideration of the application must be given as far as possible as though all the papers filed were a composite single paper.

After entry of the amendment the application is "up for action." It is forwarded to the examiner, and he or she is responsible for its proper disposal. The examiner should immediately inspect the amendment as set forth in MPEP § 714.05. After inspection, if no immediate or special action is required, the application awaits examination in regular order.

See MPEP § \*714< for the treatment of \*\* amendments that are not in compliance with 37 CFR 1.121. \*\*

### **714.19 List of Amendments, Entry Denied [R-5]**

The following types of amendments are ordinarily denied entry:

(A) An amendment presenting an unpatentable claim, or a claim requiring a new search or otherwise raising a new issue in an application whose prosecution before the primary examiner has been closed, as where

(1) All claims have been allowed,

(2) All claims have been finally rejected (for exceptions see MPEP § 714.12, § 714.13, and § 714.20, item (D)),

(3) Some claims have been allowed and the remainder finally rejected. See MPEP § 714.12 to § 714.14.

(B) Substitute specification that does not comply with 37 CFR 1.125. See MPEP § 608.01(q) and § 714.20.

(C) A patent claim suggested by the examiner and not presented within the time limit set or an extension thereof, unless entry is authorized by the Director. See MPEP Chapter 2300.

(D) While copied patent claims are generally admitted even though the application is under final

rejection or on appeal, under certain conditions, the claims may be refused entry. See MPEP Chapter 2300.

(E) An unsigned or improperly signed amendment or one signed by a suspended or excluded attorney or agent.

(F) An amendment filed in the U.S. Patent and Trademark Office after the expiration of the statutory period or set time period for reply and any extension thereof. See MPEP § 714.17.

(G) An amendment so worded that it cannot be entered with certain accuracy. See MPEP § \*714, subsection II.G.<

(H) An amendment canceling all of the claims and presenting no substitute claim or claims. See 37 CFR 1.115(b)(1), MPEP § 711.01 and § 714.01(e).

(I) An amendment in an application no longer within the examiner's jurisdiction with certain exceptions in applications in issue, except on approval of the Director. See MPEP § 714.16.

(J) Amendments to the drawing held by the examiner to contain new matter are not entered until the question of new matter is settled. This practice of nonentry because of alleged new matter, however, does not apply in the case of amendments to the specification and claims. See MPEP § 608.04 and § 706.03(o).

(K) An amendatory paper containing objectionable remarks that, in the opinion of the examiner, brings it within the condemnation of 37 CFR 1.3, will be submitted to the Technology Center (TC) Director. See MPEP § 714.25 and MPEP § 1003. If the TC Director determines that the remarks are in violation of 37 CFR 1.3, he or she will notify the applicant of the non-entry of the paper.

(L) Amendments not in permanent ink. Amendments on so-called "easily erasable paper." See MPEP § 714.07.

(M) An amendment presenting claims (total and independent) in excess of the number previously paid for and not accompanied by the full fee for the claims or an authorization to charge the fee to a deposit account or credit card. See MPEP § 509 and § 607.

(N) An amendment canceling all claims drawn to the elected invention and presenting only claims drawn to the nonelected invention should not be entered. Such an amendment is nonresponsive. Appli-

cant should be notified as directed in MPEP § 714.03 and § 714.05. See MPEP § 821.03.

(O) An amendment including changes to the specification/claims which is not in compliance with 37 CFR 1.121, e.g., one which does not include replacement paragraphs or claim listings. See MPEP § 714.

(P) A preliminary amendment that unduly interferes with the preparation of a first Office action. Factors to be considered in denying entry of the preliminary amendment are set forth in 37 CFR 1.115(b). See MPEP § 714.01(e).

(Q) A supplemental reply is not entered as a matter of right unless it is filed during a suspension period under 37 CFR 1.103(a) or (c). See 37 CFR 1.111(a)(2) and MPEP § 714.03(a).

While amendments falling within any of the foregoing categories should not be entered by the examiner at the time of filing, a subsequent showing by applicant may lead to entry of the amendment.

#### **714.20 List of Amendments Entered in Part [R-2]**

To avoid confusion of the record the general rule prevails that an amendment should not be entered in part. \*\*>At times<, the strict observance of its letter may sometimes work more harm than would result from its infraction, especially if the amendment in question is received at or near the end of the period for reply. Thus:

(A) An “amendment” presenting an unacceptable substitute specification along with amendatory matter, as amendments to claims or new claims, should be entered in part, rather than refused entry *in toto*. The substitute specification should be denied entry and so marked, while the rest of the paper should be entered. The application as thus amended is acted on when reached in its turn, the applicant being advised that the substitute specification has not been entered.

See 37 CFR 1.125 and MPEP § 608.01(q) for information regarding the submission of a substitute specification.

Under current practice, substitute specifications may be voluntarily filed by the applicant if he or she desires. A proper substitute specification will nor-

mally be accepted by the Office even if it has not been required by the examiner. >However, entry of a substitute specification filed after the notice of allowance has been mailed (37 CFR 1.312) is not a matter of right.<

(B) An amendment under 37 CFR 1.312, which in part is approved and in other part disapproved, is entered only as to the approved part. See MPEP § 714.16(e).

(C) In an application in which prosecution on the merits is closed, i.e., after the issuance of an *Ex Parte Quayle* action, where an amendment is presented curing the noted formal defect and adding one or more claims some or all of which are in the opinion of the examiner not patentable, or will require a further search, the amendment in such a case will be entered only as to the formal matter. Applicant has no right to have new claims considered or entered at this point in the prosecution.

(D) In an amendment accompanying a motion granted only in part, the amendment is entered only to the extent that the motion was granted.

\*\*

**NOTE.** The examiner writes “Enter” in red ink and his or her initials in the left margin opposite the enterable portions. >For Image File Wrapper (IFW) processing, see IFW Manual.<

#### **714.21 Amendments Inadvertently Entered, No Legal Effect [R-2]**

If the technical support staff inadvertently enters an amendment when it should not have been entered, such entry is of no legal effect, and the same action is taken as if the changes had not been actually made, inasmuch as they have not been legally made. Unless such unauthorized entry is deleted, suitable notation should be made on the margin of the amendatory paper, as “Not Officially Entered.” >For Image File Wrapper (IFW) processing, see IFW Manual.<

If an amendatory paper is to be retained in the file, even though not entered, it should be given a paper number and listed on the file wrapper with the notation “Not Entered.” See 37 CFR 1.3 and MPEP § 714.25 for an example of a paper which may be \*>denied entry<.

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## 714.25 Discourtesy of Applicant or Attorney [R-2]

\*\*&gt;

*37 CFR 1.3. Business to be conducted with decorum and courtesy.*

Applicants and their attorneys or agents are required to conduct their business with the United States Patent and Trademark Office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Director and will not be entered. A notice of the non-entry of the paper will be provided. Complaints against examiners and other employees must be made in correspondence separate from other papers.<

All papers received in the U.S. Patent and Trademark Office should be briefly reviewed by the technical support staff, before entry, sufficiently to determine whether any discourteous remarks appear therein.

If the attorney or agent is discourteous in the remarks or arguments in his or her amendment, either the discourtesy should be entirely ignored or the paper submitted to the Technology Center (TC) Director \*\*>for review<. See MPEP § 1003. If the TC Director determines that the remarks are in violation of 37 CFR 1.3, the TC Director will \*\*>send a notice of non-entry of the paper to the applicant<.

## 715 Swearing Back of Reference — Affidavit or Declaration Under 37 CFR 1.131 [R-3]

*37 CFR 1.131. Affidavit or declaration of prior invention.*

(a) When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based. The effective date of a U.S. patent, U.S. patent application publication, or international application publication under PCT Article 21(2) is the earlier of its publication date or date that it is effective as a reference under 35 U.S.C. 102(e). Prior invention may not be established under this section in any country other than the United States, a NAFTA country, or a WTO member country. Prior invention may not be established under this section before December 8, 1993, in a NAFTA country other than the United States, or before January 1, 1996, in a WTO member country other than a NAFTA country. Prior invention may not be established under this section if either:

\*\*&gt;

(1) The rejection is based upon a U.S. patent or U.S. patent application publication of a pending or patented application to another or others which claims the same patentable invention as defined in § 41.203(a) of this title, in which case an applicant may suggest an interference pursuant to § 41.202(a) of this title; or<

(2) The rejection is based upon a statutory bar.

\*\*&gt;

(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained.<

37 CFR 1.131(a) has been amended to implement the relevant provisions of Public Law 103-182, 107 Stat. 2057 (1993) (North American Free Trade Agreement Act), Public Law 103-465, 108 Stat. 4809 (1994) (Uruguay Round Agreements Act), and Public Law 106-113, 113 Stat. 1501 (1999) (American Inventors Protection Act), respectively. Under 37 CFR 1.131(a) as amended, which provides for the establishment of a date of completion of the invention in a NAFTA or WTO member country, as well as in the United States, an applicant can establish a date of completion in a NAFTA member country on or after December 8, 1993, the effective date of section 331 of Public Law 103-182, the North American Free Trade Agreement Act, and can establish a date of completion in a WTO member country other than a NAFTA member country on or after January 1, 1996, the effective date of section 531 of Public Law 103-465, the Uruguay Round Agreements Act (URAA). Acts occurring prior to the effective dates of NAFTA or URAA may be relied upon to show completion of the invention; however, a date of completion of the invention may not be established under 37 CFR 1.131 before December 8, 1993 in a NAFTA country or before January 1, 1996 in a WTO country other than a NAFTA country.

If a country joined the WTO after January 1, 1996, the effective date for proving inventive activity in that country for the purpose of 35 U.S.C. 104 and 37 CFR 1.131 is the date the country becomes a member of the WTO. See MPEP § 201.13 for a list that includes WTO member countries (the notation "W<sup>o</sup>" indicates

# **EXHIBIT F**

[Added, 69 FR 29865, May 26, 2004, effective June 25, 2004; paras. (a) and (c)(3) revised, 70 FR 56119, Sept. 26, 2005, effective Nov. 25, 2005]

**§ 1.33 Correspondence respecting patent applications, reexamination proceedings, and other proceedings.**

(a) *Correspondence address and daytime telephone number.* When filing an application, a correspondence address must be set forth in either an application data sheet (§ 1.76 ), or elsewhere, in a clearly identifiable manner, in any paper submitted with an application filing. If no correspondence address is specified, the Office may treat the mailing address of the first named inventor (if provided, see §§ 1.76 (b)(1) and 1.63 (c)(2)) as the correspondence address. The Office will direct, or otherwise make available, all notices, official letters, and other communications relating to the application to the person associated with the correspondence address. For correspondence submitted via the Office's electronic filing system, however, an electronic acknowledgment receipt will be sent to the submitter. The Office will generally not engage in double correspondence with an applicant and a patent practitioner, or with more than one patent practitioner except as deemed necessary by the Director. If more than one correspondence address is specified in a single document, the Office will select one of the specified addresses for use as the correspondence address and, if given, will select the address associated with a Customer Number over a typed correspondence address. For the party to whom correspondence is to be addressed, a daytime telephone number should be supplied in a clearly identifiable manner and may be changed by any party who may change the correspondence address. The correspondence address may be changed as follows:

(1) Prior to filing of § 1.63 oath or declaration by any of the inventors. If a § 1.63 oath or declaration has not been filed by any of the inventors, the correspondence address may be changed by the party who filed the application. If the application was filed by a patent practitioner, any other patent practitioner named in the transmittal papers may also change the correspondence address. Thus, the inventor(s), any patent practitioner named in the transmittal papers accompanying the original application, or a party that will be the assignee who filed the application, may

change the correspondence address in that application under this paragraph.

(2) *Where a § 1.63 oath or declaration has been filed by any of the inventors.* If a § 1.63 oath or declaration has been filed, or is filed concurrent with the filing of an application, by any of the inventors, the correspondence address may be changed by the parties set forth in paragraph (b) of this section, except for paragraph (b)(2).

(b) *Amendments and other papers.* Amendments and other papers, except for written assertions pursuant to § 1.27(c)(2)(ii) of this part, filed in the application must be signed by:

(1) A patent practitioner of record appointed in compliance with § 1.32(b);

(2) A patent practitioner not of record who acts in a representative capacity under the provisions of § 1.34;

(3) An assignee as provided for under § 3.71(b) of this chapter; or

(4) All of the applicants (§ 1.41(b)) for patent, unless there is an assignee of the entire interest and such assignee has taken action in the application in accordance with § 3.71 of this chapter.

(c) All notices, official letters, and other communications for the patent owner or owners in a reexamination proceeding will be directed to the correspondence address. Amendments and other papers filed in a reexamination proceeding on behalf of the patent owner must be signed by the patent owner, or if there is more than one owner by all the owners, or by an attorney or agent of record in the patent file, or by a registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34. Double correspondence with the patent owner or owners and the patent owner's attorney or agent, or with more than one attorney or agent, will not be undertaken.

(d) A "correspondence address" or change thereto may be filed with the Patent and Trademark Office during the enforceable life of the patent. The "correspondence address" will be used in any correspondence relating to maintenance fees unless a separate "fee address" has been specified. See § 1.363 for "fee address" used solely for maintenance fee purposes.

(e) A change of address filed in a patent application or patent does not change the address for a

patent practitioner in the roster of patent attorneys and agents. See § 11.11 of this title.

[36 FR 12617, July 2, 1971; 46 FR 29181, May 29, 1981; para. (d) added, 49 FR 34724, Aug. 31, 1984, effective Nov. 1, 1984; para. (c), 50 FR 5171, Feb. 6, 1985, effective Mar. 8, 1985; paras. (a) & (b) revised, 62 FR 53131, Oct. 10 1997, effective Dec. 1, 1997; paras. (a) and (b) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; (a) introductory text, (b) introductory text, and paras. (b)(1), (b)(2) and (c) revised, 69 FR 29865, May 26, 2004, effective June 25, 2004; para. (c) revised, 69 FR 35427, June 24, 2004, effective July 26, 2004; para. (c) revised, 70 FR 3880, Jan. 27, 2005, effective Dec. 8, 2004; para. (a) introductory text revised, paras. (a)(1), (b)(1), and (b)(2) revised, and para. (e) added, 70 FR 56119, Sept. 26, 2005, effective Nov. 25, 2005; para. (a) introductory text revised, 72 FR 2770, Jan. 23, 2007, effective Jan. 23, 2007; para. (c) revised, 72 FR 18892, Apr. 16, 2007, effective May 16, 2007]

#### **§ 1.34 Acting in a representative capacity.**

When a patent practitioner acting in a representative capacity appears in person or signs a paper in practice before the United States Patent and Trademark Office in a patent case, his or her personal appearance or signature shall constitute a representation to the United States Patent and Trademark Office that under the provisions of this subchapter and the law, he or she is authorized to represent the particular party on whose behalf he or she acts. In filing such a paper, the patent practitioner must set forth his or her registration number, his or her name and signature. Further proof of authority to act in a representative capacity may be required.

[46 FR 29181, May 29, 1981; para. (a), 50 FR 5171, Feb. 6, 1985, effective Mar. 6, 1985; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; revised, 69 FR 29865, May 26, 2004, effective June 25, 2004; revised, 70 FR 56119, Sept. 26, 2005, effective Nov. 25, 2005]

#### **§ 1.36 Revocation of power of attorney; withdrawal of patent attorney or agent.**

(a) A power of attorney, pursuant to § 1.32(b), may be revoked at any stage in the proceedings of a case by an applicant for patent (§ 1.41(b)) or an assignee of the entire interest of the applicant, or the owner of the entire interest of a patent. A power of

attorney to the patent practitioners associated with a Customer Number will be treated as a request to revoke any powers of attorney previously given. Fewer than all of the applicants (or fewer than all of the assignees of the entire interest of the applicant or, in a reexamination proceeding, fewer than all the owners of the entire interest of a patent) may revoke the power of attorney only upon a showing of sufficient cause, and payment of the petition fee set forth in § 1.17(f). A patent practitioner will be notified of the revocation of the power of attorney. Where power of attorney is given to the patent practitioners associated with a Customer Number (§ 1.32(c)(2)), the practitioners so appointed will also be notified of the revocation of the power of attorney when the power of attorney to all of the practitioners associated with the Customer Number is revoked. The notice of revocation will be mailed to the correspondence address for the application (§ 1.33) in effect before the revocation. An assignment will not of itself operate as a revocation of a power previously given, but the assignee of the entire interest of the applicant may revoke previous powers of attorney and give another power of attorney of the assignee's own selection as provided in § 1.32(b).

(b) A registered patent attorney or patent agent who has been given a power of attorney pursuant to § 1.32(b) may withdraw as attorney or agent of record upon application to and approval by the Director. The applicant or patent owner will be notified of the withdrawal of the registered patent attorney or patent agent. Where power of attorney is given to the patent practitioners associated with a Customer Number, a request to delete all of the patent practitioners associated with the Customer Number may not be granted if an applicant has given power of attorney to the patent practitioners associated with the Customer Number in an application that has an Office action to which a reply is due, but insufficient time remains for the applicant to file a reply. See § 41.5 of this title for withdrawal during proceedings before the Board of Patent Appeals and Interferences.

[49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; revised, 69 FR 29865, May 26, 2004, effective June 25, 2004; revised, 69 FR 49959, Aug. 12, 2004, effective

# **EXHIBIT G**



treated under § 1.27(g)(2) as a notification of a loss of entitlement to small entity status.

[47 FR 40140, Sept. 10, 1982, added effective Oct. 1, 1982; para. (a), 49 FR 553, Jan. 4, 1984, effective Apr. 1, 1984; para. (d)(2), 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992; para. (c) revised, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994; para. (a) revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; paras. (a) & (c) revised, 62 FR 53131, Oct. 10 1997, effective Dec. 1, 1997; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

## Subpart B — National Processing Provisions

### PROSECUTION OF APPLICATION AND APPOINTMENT OF ATTORNEY OR AGENT

#### § 1.31 Applicant may be represented by one or more patent practitioners or joint inventors.

An applicant for patent may file and prosecute his or her own case, or he or she may give a power of attorney so as to be represented by one or more patent practitioners or joint inventors. The United States Patent and Trademark Office cannot aid in the selection of a patent practitioner.

[50 FR 5171, Feb. 6, 1985, effective Mar. 8, 1985; revised, 69 FR 29865, May 26, 2004, effective June 25, 2004; revised 69 FR 35427, June 24, 2004, effective July 26, 2004; revised, 70 FR 56119, Sept. 26, 2005, effective Nov. 25, 2005]

#### § 1.32 Power of attorney.

##### (a) Definitions.

(1) *Patent practitioner* means a registered patent attorney or registered patent agent under § 11.6.

(2) *Power of attorney* means a written document by which a principal authorizes one or more patent practitioners or joint inventors to act on his or her behalf.

(3) *Principal* means either an applicant for patent (§ 1.41(b)) or an assignee of entire interest of the applicant for patent or in a reexamination proceeding, the assignee of the entirety of ownership of a

patent. The principal executes a power of attorney designating one or more patent practitioners or joint inventors to act on his or her behalf.

(4) *Revocation* means the cancellation by the principal of the authority previously given to a patent practitioner or joint inventor to act on his or her behalf.

(5) *Customer Number* means a number that may be used to:

(i) Designate the correspondence address of a patent application or patent such that the correspondence address for the patent application, patent or other patent proceeding would be the address associated with the Customer Number;

(ii) Designate the fee address (§ 1.363) of a patent such that the fee address for the patent would be the address associated with the Customer Number; and

(iii) Submit a list of patent practitioners such that those patent practitioners associated with the Customer Number would have power of attorney.

(b) A power of attorney must:

(1) Be in writing;

(2) Name one or more representatives in compliance with (c) of this section;

(3) Give the representative power to act on behalf of the principal; and

(4) Be signed by the applicant for patent (§ 1.41(b)) or the assignee of the entire interest of the applicant.

(c) A power of attorney may only name as representative:

(1) One or more joint inventors (§ 1.45);

(2) Those registered patent practitioners associated with a Customer Number;

(3) Ten or fewer patent practitioners, stating the name and registration number of each patent practitioner. Except as provided in paragraph (c)(1) or (c)(2) of this section, the Office will not recognize more than ten patent practitioners as being of record in an application or patent. If a power of attorney names more than ten patent practitioners, such power of attorney must be accompanied by a separate paper indicating which ten patent practitioners named in the power of attorney are to be recognized by the Office as being of record in the application or patent to which the power of attorney is directed.

[Added, 69 FR 29865, May 26, 2004, effective June 25, 2004; paras. (a) and (c)(3) revised, 70 FR 56119, Sept. 26, 2005, effective Nov. 25, 2005]

**§ 1.33 Correspondence respecting patent applications, reexamination proceedings, and other proceedings.**

(a) *Correspondence address and daytime telephone number.* When filing an application, a correspondence address must be set forth in either an application data sheet (§ 1.76 ), or elsewhere, in a clearly identifiable manner, in any paper submitted with an application filing. If no correspondence address is specified, the Office may treat the mailing address of the first named inventor (if provided, see §§ 1.76 (b)(1) and 1.63 (c)(2)) as the correspondence address. The Office will direct, or otherwise make available, all notices, official letters, and other communications relating to the application to the person associated with the correspondence address. For correspondence submitted via the Office's electronic filing system, however, an electronic acknowledgment receipt will be sent to the submitter. The Office will generally not engage in double correspondence with an applicant and a patent practitioner, or with more than one patent practitioner except as deemed necessary by the Director. If more than one correspondence address is specified in a single document, the Office will select one of the specified addresses for use as the correspondence address and, if given, will select the address associated with a Customer Number over a typed correspondence address. For the party to whom correspondence is to be addressed, a daytime telephone number should be supplied in a clearly identifiable manner and may be changed by any party who may change the correspondence address. The correspondence address may be changed as follows:

(1) Prior to filing of § 1.63 oath or declaration by any of the inventors. If a § 1.63 oath or declaration has not been filed by any of the inventors, the correspondence address may be changed by the party who filed the application. If the application was filed by a patent practitioner, any other patent practitioner named in the transmittal papers may also change the correspondence address. Thus, the inventor(s), any patent practitioner named in the transmittal papers accompanying the original application, or a party that will be the assignee who filed the application, may

change the correspondence address in that application under this paragraph.

(2) *Where a § 1.63 oath or declaration has been filed by any of the inventors.* If a § 1.63 oath or declaration has been filed, or is filed concurrent with the filing of an application, by any of the inventors, the correspondence address may be changed by the parties set forth in paragraph (b) of this section, except for paragraph (b)(2).

(b) *Amendments and other papers.* Amendments and other papers, except for written assertions pursuant to § 1.27(c)(2)(ii) of this part, filed in the application must be signed by:

(1) A patent practitioner of record appointed in compliance with § 1.32(b);

(2) A patent practitioner not of record who acts in a representative capacity under the provisions of § 1.34;

(3) An assignee as provided for under § 3.71(b) of this chapter; or

(4) All of the applicants (§ 1.41(b)) for patent, unless there is an assignee of the entire interest and such assignee has taken action in the application in accordance with § 3.71 of this chapter.

(c) All notices, official letters, and other communications for the patent owner or owners in a reexamination proceeding will be directed to the correspondence address. Amendments and other papers filed in a reexamination proceeding on behalf of the patent owner must be signed by the patent owner, or if there is more than one owner by all the owners, or by an attorney or agent of record in the patent file, or by a registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34. Double correspondence with the patent owner or owners and the patent owner's attorney or agent, or with more than one attorney or agent, will not be undertaken.

(d) A "correspondence address" or change thereto may be filed with the Patent and Trademark Office during the enforceable life of the patent. The "correspondence address" will be used in any correspondence relating to maintenance fees unless a separate "fee address" has been specified. See § 1.363 for "fee address" used solely for maintenance fee purposes.

(e) A change of address filed in a patent application or patent does not change the address for a